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CHARLES ELMORE

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,
Respondents.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals for the Second Circuit.

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(1) The decision of the Court below:

(a) that Patent No. 1,605,445 "was entitled to the *narrowest* of all equivalents," is in direct conflict with the decision of the United States Court of Appeals for the Eighth Circuit in Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 320, which held that "(the patent is entitled) to a broad range of equivalents approaching that accorded to a *pioneer* invention,"— and with *its own* decision in the case of Stevens v. Carl Schmid, Inc., 73 F. (2d) 54, where the same patent was held valid and infringed;

(b) that Patent No. 1,605,445 "can be thought to have been *an invention at all*" is in direct conflict with said decision of the United States Court of Appeals in Dean Rubber Mfg. Co. v. Killian, that "The machine of the patent (1,605,445) is * * * a *pioneer* invention," and

(c) is in direct conflict with the decision of the United States Court of Appeals for the Seventh Circuit in the case of E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties, 116 F. (2d) 63, 66, on the issue of whether it is presumed that knowledge of the prior art was possessed by workers in the art other than the inventor 6-7

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OCTOBER TERM, 1951.

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FRANK B. KILLIAN & COMPANY,
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vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,
Respondents.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Frank B. Killian & Company, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit in the above entitled case.

A certified transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

OPINIONS.

The Opinion of the District Court (R. 806-813) is reported at 94 F. Supp. 281. The Opinion of the Court of Appeals (R. 824-831) is reported at 188 F. (2d) 940.

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended June 25, 1948, effective September 1, 1948 (28 U. S. C., Section 1254(1)) and under Section 5(b) of Rule 38 of this Court.

The Opinion of the Court of Appeals is dated April 30, 1951 (R. 824). Petition for Rehearing or Remand (R. 833) was filed on May 15, 1951, and was denied on May 23, 1951 (R. 846).

STATUTE INVOLVED.

The Statute relied on is 35 U. S. C. 31; R. S. 4886 and the pertinent part thereof is reproduced in the appendix.

QUESTIONS PRESENTED.

1. Whether Patent No. 1,605,445 is valid and infringed.

2. Whether Patent No. 2,128,827 is valid.

3. Whether the present criteria of patentable invention are to be superseded from now on in the Second Circuit by a novel set of criteria formulated and advanced for the first time by the Court below as to:

(a) the test of "mechanic skilled in the art,"

(b) the presumption that workers in the art knew the disclosures of patents from their issuance, and

(c) the invalidating effect of "paper" patents.

4. Whether the Court below has correctly stated and followed the patent law as declared by this Court.

SPECIFICATION OF ERRORS TO BE URGED.

The Court of Appeals erred:

(1) In reversing the judgment of the District Court by holding Patent No. 1,605,445 not infringed.

(2) In reversing the judgment of the District Court by holding Patent No. 2,128,827 invalid.

(3) In holding that a patent on an invention which has been used by the entire industry for many years and has never been displaced is invalidated by a prior "paper" patent, which was incapable of doing:

(a) what the patent in suit actually did commercially or

(b) even what the "paper" patent was intended to do.

(4) In violating Rule 52(a) of the Federal Rules of Civil Procedure by reversing and disregarding Findings of Fact of the Trial Court without any showing that they were clearly erroneous and by failing to make allowance for the advantages possessed by the Trial Court that had observed demonstrations, viewed motion pictures, listened to conflicting testimony and passed on the credibility of witnesses.

(5) In holding that, with certain changes, "the Dutch machine could have been substituted for the patent in suit * * *" contrary to the finding of the Trial Court that, notwithstanding such changes, a "worthless product" would result.

(6) In holding, without support in the record and contrary to the findings of the Trial Court that "Stop the 'process' (of the Dutch patent) at two immersions and a 'prophylactic' results * * *." and "All that was needed was to stop the repetition of the 'process' of imposing 'layer upon layer of latex' at the right thickness."

(7) In holding without support in the record and contrary to the findings of the Trial Court, that a United States patent which is for a new combination of elements having a new mode of operation and for a new method and which gives a new result may be invalidated on a prior foreign "paper" patent disclosing a different combination of elements with a different mode of operation and a different method and giving a different result, which if used in an effort to produce the product of the United States patent would make a worthless article.

(8) In holding that a United States patent for a method and machine, which superseded the prior art and was adopted before the patent issued and has been used by the entire industry ever since for automatically, rapidly,

continuously and without the intervention of the human hands making from liquid latex in a combination of steps finished, ready to use, rubber articles in the form of tissue-thin, tubular sheaths weighing about 1/20 ounce, which meet the rigid inspection requirements of the United States Food & Drug Administration under the Federal Food, Drug and Cosmetic Act is invalidated by a foreign "paper" patent on a machine which was devised to make balls of raw, uncured rubber weighing from 20 to 40 pounds from latex and which at the very most and after several changes in structure, inspired by the U. S. patentee, would nevertheless produce only a "worthless" article as found by the Trial Court.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

Petitioner, Frank B. Killian & Company, is a partnership owning the entire right, title and interest in and to Killian Patent No. 1,605,445 issued November 2, 1926, and Killian Patent No. 2,128,827 issued August 30, 1938.

This action is brought by petitioner for reversal of the decision of the Court of Appeals for the Second Circuit which held the foregoing patents invalid, and for reinstatement of the decision of the United States District Court for the Southern District of New York (Bondy, *J.*) which held that both patents were valid and had been infringed.

These two Killian patents cover important steps in the manufacture of thin dipped rubber articles, including prophylactics. The first of these patents (R. 611) is for a machine for performing the operation of rolling rings at the open ends of such articles to strengthen them against tearing when stretched. The second patent (R. 617) is for a method of, and apparatus for, performing all the operations necessary to convert latex into such articles in ready-to-use condition, including the step of picking up and distributing the latex on a form shaped like the desired article. The Youngs Rubber Corporation has manufactured rubber prophylactics by use of the Killian inventions under licenses

ever since before these Killian patents were issued and has paid royalty therefor continuously since 1924.

Rubber prophylactics, such as are made by use of the inventions of these two Killian patents, are the articles which are tested for the presence of holes by the Youngs Patents Nos. 2,213,113 and 2,244,591 owned by the Youngs Rubber Corporation. This testing is to avoid violation of the Federal Food, Drug and Cosmetics Act (21 U. S. C. 301 *et seq.*) as administered by the Federal Food and Drug Administration.

Those Youngs patents are involved in the companion case of *Youngs Rubber Corporation v. Allied Latex Corporation,* 188 F. (2d) 945 (C. A. 2) in which a Petition for Certiorari is being filed concurrently herewith.

The patentee devised the inventions of the patents in suit and developed them by his own labor in his own small plant and at his own risk and expense. The inventions, by drastically decreasing the unit cost of production, enabled the users thereof to make and sell their goods at the same low price for 19 years, while labor and machinery costs were multiplying. The patentee and his partner granted licenses to all comers at a low royalty rate.

The devices of both patents promptly displaced previously used apparatus and have been widely used by manufacturers in the industry, with the payment of large sums as royalty therefor. Indeed the invention of the earlier patent has been used by the entire rubber prophylactic industry since 1925 and that of the later one by the entire latex prophylactic industry since 1932 (R. 18, 21), and neither of the inventions has ever been superseded.

No manufacturer other than the respondents has infringed upon either of these patents without suffering an injunction after trial.

The respondents entered the field with full knowledge of these patents and the litigation in which they had been

involved and appropriated these two inventions as well as the inventions of the two aforesaid Youngs patents.

There is no suggestion in the Record that the respondents did any developmental work of their own or otherwise independently arrived at the ideas embodied in the machines herein alleged to infringe.

The only issues raised by the respondents are validity and infringement. There is no suggestion that the patents have been misused; that proffered license agreements have been in any way onerous, unreasonable or restrictive; that any part of the industry has been unable to afford or in fact been deprived of the advance in technology represented in these patents; or that the petitioner has been associated with any other type of reprehensible conduct which might affect the right to equitable relief in a patent suit.

REASONS FOR GRANTING THE WRIT.

(A) There is diversity of decision here between (and within) Circuit Courts of Appeals on the same matter.

(1) The decision of the Court below:

(a) that Patent No. 1,605,445 "was entitled to the NARROWEST of all equivalents," is in direct conflict with the decision of the United States Court of Appeals for the Eighth Circuit in Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 320, which held that "(the patent is entitled) to a broad range of equivalents approaching that accorded to a PIONEER invention,"—and with ITS OWN decision in the case of Stevens v. Carl Schmid, Inc., 73 F. (2d) 54, where the same patent was held valid and infringed.

(b) that Patent No. 1,605,445 "can be thought to have been AN INVENTION AT ALL" is in direct conflict with said decision of the United States Court of Appeals in Dean Rubber Mfg. Co. v. Killian, that "The machine of the patent (1,605,445) is * * * a PIONEER invention," and

(c) is in direct conflict with the decision of the United States Court of Appeals for the Seventh Circuit in the case of E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties, 116 F. (2d) 63, 66, on the issue of whether it is presumed that knowledge of the prior art was possessed by workers in the art other than the inventor.

These three conflicts should be resolved by this Court since they are important in the adjudication of patents generally, including both patents No. 1,605,445 and No. 2,128,827 here involved, without regard to the fact that the earlier of these patents has expired.

As to the Bead Roller Patent No. 1,605,445, the Trial Court held it valid, saying:

> "Patent No. 1,605,445 is for a machine for the manufacture of uniform annular beads on the open end of thin rubber tubular articles. The machine of this patent was the first to roll such beads. It went into immediate use throughout the industry and completely replaced the former method of rolling such beads by hand. It has never been replaced, though the patent expired more than six years ago. Plaintiff's competitors procured licenses and paid royalties thereunder.
>
> "The patent was issued after consideration by the Patent Office of Hadfield Patent No. 1,097,017 and Brubaker Patent No. 1,192,383, relied on by defendants as anticipations.
>
> "The patent was held valid and infringed in Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316 (8th Cir.), cert. denied 308 U. S. 624; Stevens v. Carl Schmid, Inc., 73 F. (2d) 54 (2d Cir.), cert. denied 294 U. S. 721; and in the following unreported cases in the Eastern Division of the Northern District of Ohio: Stevens v. Stardant Rubber Co., Equity No. 2508, and Stevens v. Perfection Rubber Co., Equity No. 2507, both decided February 16, 1928; and Stevens v. J. L. Shunk Rubber Co., Equity No. 2213, decided December 21, 1927. Those courts sustained the patent after careful consideration of the Hadfield and Brubaker patents and evidence

> which was substantially the same as introduced at this trial. This court likewise concludes on the record before it that the patent is valid."

and held it infringed, saying:

> "The accused machines follow Killian and not Hadfield. Parts of the accused devices are mere mechanical equivalents of the Killian machine. In both machines the conveyor moves the form lengthwise of the rotating element while the forms are prevented from upward movement and are directly engaged with the friction member which rotates them at a uniform rate of speed. In both machines beads are rolled on the open end of thin dipped rubber articles on the forms. In mode of operation and results defendants' accused bead roller is the same as the Killian device."

Despite its former holding of validity and infringement in *Stevens v. Schmid, Inc.*, 73 F. (2d) 54 the Court below now holds that "the invention, supposing it can be thought to have been an invention at all, was entitled to the narrowest of all equivalents." (R. 827.)

In line with that prior decision of the Court below and in contrast with the present decision of that Court, the Court of Appeals for the Eighth Circuit in *Dean Rubber Mfg. Co. v. Killian*, 106 F. (2d) 316, 320, held that:

> "The machine of the patent is * * * a *pioneer** invention."

and

> "(The patent is entitled) to a *broad* range of equivalents approaching that accorded to a pioneer invention."

When Patent No. 1,605,445 reached the Court below in this case, it had been held valid and infringed three times by the late Judge Westenhaver, twice by Judge Bondy, once by Judge Reeves and once each by the Courts of Appeals for the Second and Eighth Circuits with certiorari

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* Emphasis throughout this Petition is ours unless otherwise stated.

denied in both cases. All the judges who decided these cases were long experienced and highly skilled in patent law. The sound reasoning and law on which this patent was unanimously sustained in all those cases were then, and, we submit, are still, the reasoning and law in this Court.

The Court below held non-infringement *solely* on the ground that the claims of the patent recited *a* brush and the accused device had *two* brushes. This holding that the accused device is outside of the *scope of the patent* is contrary to the basic principle of patent law stated by this Court in its decision in the case of *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U. S. 605, as follows:

> "If accused matter falls clearly within the claim, infringement is made out and that is the end of it." (p. 607)
>
> "The theory on which it (the doctrine of equivalents) is founded is that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape' " (p. 608).

It is undeniable that every element of the claims of Patent No. 1,605,445 in suit is present in respondents' bead roller as clearly appears from plates 3 and 7 of Ex. 6 (R. 643, 647). Moreover, the proof shows that the accused bead roller "performs substantially the same function in substantially the same way to obtain the same result" as the patented bead roller and that "the two devices do the same work in substantially the same way, and accomplish the same result." (R. 122-123.) *Linde v. Graver*, 339 U. S. 605, 608.

The addition of a "functionless" roller to the teaching of Patent No. 1,605,445 (which is all that the respondents did as found by the Trial Court), does not avoid infringement. The Court below in holding the contrary appears to be sanctioning "a fraud on a patent"—*Graver v. Linde*, 339 U. S. 605, 608.

In the present case the Court below did not attempt to show that any of the prior decisions on *validity* was wrong in any respect whatever. Indeed, the Court quoted with approval Judge Westenhaver's holdings that he thought the device disclosed by the Hadfield patent "would not have operated," that "With all the industry needing and calling for the Killian apparatus, all manufacturers continued for fourteen years using hand labor, wholly uninfluenced by the existence of Hadfield" (R. 825), and that Hadfield did not " 'enrich the art' " (R. 827).

In the light of the foregoing facts, it is indeed astounding that the Court below could hold, as it did, that

> "the invention, supposing it can be thought to have been an invention at all, was entitled to the narrowest of all equivalents." (R. 827.)

But the decision is no more astounding than the manner in which it was reached. The Court reached that decision by the simple expedient of ignoring history and, on an assumption unsupported by the record and contradicted by logic, following a rule without precedent in any other Court, which it variously stated as follows:

> "The fact that the art has not profited by them (paper patents) is irrelevant unless it also appears that they were generally known; * * *" [he, the patentee must show] "that the art in fact knew the earlier steps, already taken"; (R. 826)—"* * * he must appraise the art's ineptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware." (R. 831.)

This unprecedented rule was also applied to invalidate Patent No. 2,128,827.

> "As in the case of Hadfield's patent, we should have to be satisfied that the Dutch machine had been widely known in the art," (R. 831).

As to the Distributing Patent, No. 2,128,827, the Trial Court held it valid, saying:—

"Killian Patent No. 2,128,827 is for a method and apparatus for manufacturing automatically, rapidly, continuously and without the intervention of human hands complete and ready to use thin dipped rubber goods such as prophylactics. The steps in the method disclosed were automatically forming a film of latex of desired thickness in its various parts, rolling a bead on the open end of the film, curing the film, dusting the article and removing the dusted article from the form ready for use." (R. 809.)

"What Killian accomplished, and what the art did not have until he appeared with his invention, was the removal of a considerable quantity of latex from a bath on a form and transportation thereof away from the bath while retaining it and distributing it on the form and while causing the latex to set in the distributed position, controlling the distribution of latex on the form by simultaneously rotating and oscillating the form and providing a continuous process for making dipped rubber goods such as prophylactics from latex and making a machine which can do continuously and automatically and rapidly what had previously been done step by step with the aid of manual labor. This involved invention. See Goodyear Co. v. Ray-O-Vac Co., 321 U. S. 275, 279; Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45, 63; Hildreth v. Mastoras, 257 U. S. 27, 34; Expanded Metal v. Bradford, 214 U. S. 366; Dean Rubber Mfg. Co. v. Killian, 106 F. (2d) 316, 320." (R. 810-811.)

"Latex prophylactic makers in this country adopted the Killian method and apparatus under license agreements and paid royalties thereunder." (R. 811.)

"The prior art relied on by defendants was cited by the Patent Office before granting the patent. The Dutch Patent No. 2002 and Williams Patent No. 1,180,-358 are the two prior art patents on which defendants mainly rely. The object of the Dutch invention was to make solid balls of crude rubber from latex, and involved the coagulation of the latex by means of smoke

or other volatile means. It was not designed for thin walled articles such as prophylactics. The stick on which the balls were formed did not oscillate above and below the horizontal. It was kept horizontal throughout its travel outside the latex bath. The Dutch disclosure can not be adapted, without changes in operation, to produce the Killian films. There is no proof that the Dutch Patent was ever put to use even to make crude rubber balls." (R. 811.)

The Court below made no attempt to show that any of the foregoing Findings of Fact of the Trial Court was clearly erroneous. Nor did the Court challenge either the reasoning or authorities relied on by the Trial Court. On the contrary, the Court below made the following Findings favorable to validity:

"Killian is entitled to whatever merit is due to the first person who satisfies a long existing need. Moreover, presumably he designed his machine from the ground up and without suggestion or cue; and we may well agree that, taken as a feat, that *displayed enough originality to support a patent.*

* * * * *

"It is true that the two machines (Killian and the Dutch patent) were not identical and their purposes were *widely different,* * * *" (R. 829).

"* * * he (Killian) did add the feature that, after a 'form' had been dipped in its bath of latex and had been raised back again to horizontal, it was raised, still rotating, above the horizontal, so as to insure a more uniform spread of latex. *The Dutch patent did not disclose that step* * * *." (R. 829.)

Nevertheless, the unprecedented rule, applied as stated above to invalidate the Bead Roller Patent, was again invoked by the Court to invalidate this Distributing Patent. (R. 831.)

In invalidating both patents on the presumption (c) (*supra,* p. 7), that workers other than the inventor were

ignorant of the prior patented art, the decision below is in direct conflict with that of the United States Court of Appeals for the Seventh Circuit in *E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties,* 116 F. (2d) 63, where it was held (p. 66) both as to a prior United States patent and as to a prior foreign patent, that other workers in the art

> "* * * will be presumed to have known of its disclosure *since its issue* * * *."

This contrary rule was evolved by the Court below on the theory that

(a) a patent is not used because it is unknown to workers in the art, and

(b) had such patent been known to workers in the art, it would promptly have been adapted to the purposes of the patent in suit.

It was error for the Court below to assume, as it did, that all workers in the art are ignorant of the entire patent literature. That assumption loses sight of the actualities, for industry generally keeps abreast of the patent literature and hordes of patent searchers are constantly at work in the Scientific Library and Search Room of the United States Patent Office, to aid industry in this endeavor. All patents, domestic and foreign, including "paper" patents, are constantly being examined there by these searchers and by them made known to their clients. The Court below not only shut its eyes to this well known fact, but to the contrary, without the slightest basis, took unwarranted judicial notice that it is "a most unlikely possibility" that either the U. S. patent to Hadfield or the Dutch patent "had been widely known in the art." The Court below went so far as to presume complete ignorance on the part of workers in the art, of the patent literature in their own field.

Patent disclosures are used whenever it is worth while to use them in our competitive system and the almost universal reason why patent disclosures are not used is

because they are impractical or inoperative, as illustrated by the Hadfield patent and Dutch patent in this case.

As his patent shows (R. 770), when he filed his application on an alleged bead roller, Hadfield lived in Akron, Ohio, then the center of the rubber industry in this country. Is it conceivable that the rubber workers in Akron did not know about the Hadfield patent during the fourteen years following its issuance and during which all manufacturers were needing the Killian invention to eliminate hand bead rolling?

This Court in the case of *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 420 held under similar circumstances:

> "* * * if the Deighton patent had been adaptable to the Jones process, it is scarcely possible that its merits should have failed to seize upon the attention of manufacturers,"

The same reasoning applies even more forcefully to the Dutch patent, since it was for a "widely different" purpose and was proved incapable of performing its intended purpose (R. 583-588) and, like the Hadfield patent, had not been used during the time between its issuance and Killian's entry into the field.

The speciousness of this unprecedented rule formulated by the court below is readily demonstrated.

France and certain other countries issue patents without examination and hence in those countries patents may issue on devices which are quite inoperative, such as a perpetual motion machine, or which cannot be made operative by resort to any obvious or any well known mechanical expedient. Even in countries where patent applications are examined, patents may issue on devices which will not operate as described or intended, as witness the Dutch patent in this case.

As the Court below would have it, a prior patent disclosing a device useless either because of inoperativeness,

or inability to perform as intended could serve to invalidate a patent on a device of great commercial use and value simply because the prior patent was not proved to be "generally" or "widely known in the art."

Though petitioner, by its Petition for Remand or Rehearing, stood ready to prove that the Hadfield and Dutch patents were "widely known in the art," that Petition was nevertheless summarily denied.*

By putting on the inventor the burden of *proving general knowledge of a failure,* the Court below relieved respondents of a burden of proof which this Court has consistently placed upon those attacking a patent.

> "A patent regularly issued, and even more obviously a patent issued after a hearing of all the rival claimants, is presumed to be valid until the presumption has been overcome by convincing evidence of error."
>
> *Radio Corporation of America, et al. v. Radio Engineering Laboratories, Inc.,* 293 U. S. 1, 7.

> "Not only is the burden to make good this defense (want of novelty) upon the party setting it up, but his burden is a heavy one, as it has been held that 'every reasonable doubt should be resolved against him'."
>
> *Mumm v. Decker,* 301 U. S. 168, 171.

This burden of proof should certainly be no lighter where the defense is based, as here, on mere "paper" patents, the devices of which could not even do what the patents said they were to do.

Had it not relieved respondents from that burden, it is doubtful that the Court below could, on its own reasoning, have reversed the Trial Court.

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* The foregoing rule, and others, newly formulated by the Court below in this case and set out herein, have already been applied generally by the Court below in the case of *Landis Machine Co. et al. v. Parker-Kalon Corp. et al.,* 90 USPQ 129, decided July 11, 1951. Moreover, the Court below, of its own volition, remanded that case for the taking of proof of the very kind which it had refused us leave to take.

(2) The decision of the Court below is in conflict with the decision of the Court of Appeals for the Sixth Circuit on the issue of whether a patent in suit may be invalidated by a "paper" patent which was not conceived, disclosed, adaptable by obvious and well-known expedients, or adapted, to accomplish the ends of the patent in suit.

Since paper patents are almost invariably relied on as defenses in patent infringement suits, it is important that this conflict be resolved by this Court.

A "paper" patent is one which discloses a device that has never been used commercially. The paper patent rule was initiated by this Court in *Carnegie v. Cambria,* 185 U. S. 403, 421-422 and has been followed by this Court in *Williams v. United Shoe Mach. Corp.,* 316 U. S. 364, affirming the decision of the Court of Appeals for the Sixth Circuit, 121 F. (2d) 273, 278, and by other courts including *Hutzler Bros. Co. et al. v. Sales Affiliates, Inc.,* 164 F. (2d) 260, 266 (C. A. 4), and *Wahl v. Andis,* 66 F. (2d) 162, 165 (C. A. 7). The rule was fully and succinctly stated by the Court of Appeals for the Sixth Circuit in the case of *Trabon v. Dirkes,* 136 F. (2d) 24, 26 as follows:

> "We have no doubt that paper patents which precisely disclose the purpose, means, and mechanism for accomplishing the end of a patent in suit, or which may be adapted for that purpose by obvious and common mechanical expedients, may be regarded as anticipatory in that they disclose lack of novelty in an assailed invention. Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 423, 22 S. Ct. 698, 46 L. Ed. 968. But an organization that was neither conceived nor disclosed by the prior inventor, nor adapted by obvious or well-known mechanical expedients, will not convert a prior patent into an anticipation. Topliff v. Topliff, 145 U. S. 156, 12 S. Ct. 825, 36 L. Ed. 658; Gordon Form Lathe Co. v. Walcott Mach. Co., 6 Cir., 32 F. 2d 55. The fact that a prior art device, even though adaptable, was not in fact adapted, strongly indicates that the

changes were not obvious and involve more than mechanical skill. Potts & Co. v. Creager, 155 U. S. 597, 15 S. Ct. 194, 39 L. Ed. 275; Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527."

In the case at bar, the Trial Court cited and adhered to the rule of the *Trabon* case, but the Court of Appeals, in reversing the Trial Court, abrogated that rule in the following terms:

"The phrase 'paper patent' is a mere bit of rhetoric usually employed as a makeweight by judges who wish to support the patent in suit, but are embarrassed by a reference, of an escape from which they are not too confident. It is a meaningless platitude." (R. 826-7.)

Moreover, in modifying, reorganizing and adapting the Dutch patent, admittedly for a "widely different" purpose, to invalidate Patent No. 2,128,827, the Court below has nullified the test long ago announced by this Court in the case of *Seymour v. Osborne,* 11 Wall. 516, 555 and followed more recently in the case of *Carson v. American Smelting & Refining Co.,* 4 F. (2d) 463, 465 (C. A. 9) as follows:

> "*A foreign patent is to be measured as anticipatory not by what might have been made out of it, but by what is clearly and definitely expressed in it.* An American patent is not anticipated by a prior foreign patent unless the latter exhibits the invention in such full, clear and exact terms as to enable any person skilled in the art to practice it without the necessity of making experiments."

(B) Important Questions of Patent Law Have Been Decided in a Manner Which is in Conflict With Applicable Decisions of This Court.

(1) The decision here ignores the test of invention based on the standard of something more than could be accomplished by the "mechanic skilled in the art" which is the rule in this Court, and by substituting the standard of something more than could be accomplished by another "inventor," the decision below sets up an impossible standard. IF ALLOWED TO STAND, THE DECISION HERE WOULD INEVITABLY INVALIDATE, IN THE SECOND CIRCUIT, EVERY PATENT REGARDLESS OF ITS MERIT.

That "mechanic skilled in the art" standard has recently been defined by this Court, as follows:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity * * * than the work of a mechanic skilled in the art.'" (citing many cases.) *Sinclair & Carroll Co. v. Interchemical Corporation*, 325 U. S. 327, 330.

The Court below has substituted an *inventor* for that "mechanic skilled in the art." (R. 830.) Moreover that substitution was made and applied *ex post facto* in this case. Paraphrasing this Court's above cited definition, as the Court below would have it, it becomes the rule that it is "an essential requirement for the validity of a patent that the subject matter display 'more ingenuity than the work of an *inventor*.'"

And in so substituting an *inventor* the Court below selected a special kind of mythical *inventor*. That mythical *inventor* must not only be an inventor but he must be a perseverent, active (not a sluggish) "experimenter," "an inventor, bent on adapting" a prior apparatus to the patentee's purposes. (R. 830.) Moreover, that mythical inventor must also be *presumed* to have had the *insight* to

recognize that the prior device *might be adapted* to the purposes of the patent in suit, even though as here, that device was for a "widely different" purpose and could not do even what it was supposed to do, much less accomplish the purpose of the patent in suit. (R. 583-588.)

The Court of Appeals begs the question in assuming, as it does, that "if an inventor wished to supply the market with such articles (prophylactics) and had the Dutch disclosure before him," (R. 830) he would have had the insight even to imagine that the Dutch disclosure could give him any guidance for his "widely different" purpose. *An "inventor" but not a "mechanic skilled in the art" would have such insight;* for this Court has held that:

> "invention consisting rather in the idea that such change could be made, than in making the necessary mechanical alterations." *Hobbs v. Beach,* 180 U. S. 383, 393.

We know of no decision of this Court which even so much as countenances any such substitute for the "mechanic skilled in the art" as a basis for determining invention as against mechanical skill. Obviously, if this new rule is permitted to become the law, patents generally, including patents which this Court has held were pioneer patents, would be held invalid, for practically every patent has some antecedent even though it resembles the patent in suit "only as the anatomy of a corpse resembles that of the living being." *Consolidated Valve Co. v. Crosby Valve Co.,* 113 U. S. 157, 171; 141 U. S. 441, 448.

If this extremely harsh rule is to serve as a precedent, as it unquestionably will, if allowed to stand, then the policy of encouraging invention through the incentive of patents is vitiated. *Patent protection for "improvements" would become a thing of the past, despite the clear wording of the patent statutes* (35 U. S. C. 31, R. S. 4886). Such rule would impel the patent bar to counsel inventors and investors "to foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system." *Graver v. Linde,* 339 U. S. 605, 607.

(2) The decision of the Court below is in conflict with this Court's interpretation of Rule 52(a) of the Federal Rules of Civil Procedure. The pertinent part of that rule is as follows:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 275, this Court said:

> "The rule requires that an appellate court make allowance for the advantages possessed by the trial court in appraising the significance of conflicting testimony and reverse only 'clearly erroneous' findings."

In raising this point we do not suggest that the ultimate conclusion of invention or no invention is a finding of fact; nor do we suggest that conclusions on a slightly subsidiary level with respect to the difficulty or lack of difficulty involved in a given achievement may not involve mixed questions of law and fact. As this Court has made clear, there is a Constitutional and statute-implemented legal concept of "invention." What we do submit is that in patent cases as in other cases there are, subsidiary to the above considerations, extremely important factual issues which can only be explored on the trial level in each case and which, once "determined" on that level, normally set the factual premises for any further pursuit of the particular litigation. This fundamental principle governing appeals—of which Rule 52(a) is a re-affirmation—has always been assumed to work both ways. The discussion which follows is based on that assumption.

The Court below did not rule that the Findings of Fact of the Trial Court were clearly erroneous, nor did it expressly disagree with any of those findings, and yet it *completely nullified them.* It so nullified them by the device of making Findings of Fact incompatible with the findings of

the Trial Court and having no support in the record, as appears from the following consideration of Patent No. 2,128,827.

The Trial Court made Findings of Fact quoted above on pages 11, 12.

The operation of the Dutch disclosure was demonstrated in open Court with supporting testimony, and it was shown that that disclosure, if applied to make prophylactics, would produce a "worthless product" (R. 248-255) as the Trial Court indeed held (R. 812).

Without even attempting to show that the Findings of Fact of the Trial Court were clearly erroneous, the Court below nullified those findings by substituting its own findings as follows:

> "* * * with one exception they are so far alike that the Dutch machine could have been substituted for the patent in suit after changes that certainly could not of themselves sustain a patent." (R. 829.)
>
> "Stop the 'process' at two immersions and a 'prophylactic' results; that, coupled with the mechanical changes that we have mentioned, is the full measure of all that can be attributed to Killian." (R. 830.)

The alleged obviousness of these changes is quite incompatible with the Trial Court's Findings of Fact and wholly contrary to the evidence on which such findings are based.

Patent No. 2,128,827 discloses operations and apparatus for rolling a bead on the open end of the rubber film, curing that film, dusting the resulting article and removing it from the form. *The disclosure of the Dutch patent does not include facilities intended for or capable of performing any of these operations.*

If a stick or form with a film of latex on it were passed through the smoke chamber of the Dutch patent, most of the latex on the end of the form would flow onto the cylindrical part of the form resulting in a "worthless product,"

as found by the Trial Court (R. 812). Moreover, the rubber of the latex on the sticks would be coagulated and would form a sticky coating of uncured, unvulcanized rubber which, if rolled upon itself, in attempted removal from the form, would become a solid doughnut that could not be unrolled (R. 586-588).

In proceeding as it did with respect to both patents in suit, *the Court below failed to comply with either the language or intent of the rule and failed to heed the admonitions of the rule, and of this Court to give due regard to the opportunity of the Trial Court to judge of the credibility of the witnesses.* As in *Graver v. Linde,* the Trial Judge in the present case viewed motion pictures of the patented and the infringing apparatus in operation, observed demonstrations of the prior art and of the patented devices in open Court, heard and saw experts and other witnesses testify and resolved conflicting testimony.

Since this rule 52(a) is Statute law which all other United States Courts of Appeals have heeded* in letter and in spirit, the Court below should be brought into line.

---

* *Bozarjian v. Woods,* 175 F. (2d) 483 (C. A. 1);
Franz v. General Motors, 176 F. (2d) 80 (C. A. 3);
Great Atlantic & Pacific Tea Co. v. Jones, 177 F. (2d) 166 (C. A. 4);
Acadian v. Land, 153 F. (2d) 151 (C. A. 5);
Wallings v. General Industries, 155 F. (2d) 711; (C. A. 6) aff. 330 U. S. 545;
Falkenberg v. Bernard Edward Co., 175 F. (2d) 427 (C. A. 7);
Trico v. Delman, 180 F. (2d) 529 (C. A. 8);
Pointer v. Six Wheel, 177 F. (2d) 153 (C. A. 9);
Davies v. Lahann, 145 F. (2d) 656 (C. A. 10).

(3) The Court below, in disregarding the well-established History Test applied by this Court and other Courts in determining the issue of invention, has misapprehended the purport of this Court's recent patent decisions.

In the opinion below the Court of Appeals for the Second Circuit suggests that this Court has recently rejected what were previously clear legal standards of invention, and indicates that, in a "not to be outdone" mood, it will see to it that what formerly were considered meritorious patents will not be upheld in the Second Circuit from this day. It is submitted that the opinion below in this case, like that in the companion case, *Youngs Rubber Corporation v. Allied Latex Corporation,* 188 F. (2d) 945, is in this respect a sort of "trial balloon."

The current position of the Court of Appeals is perhaps most clearly expressed in that companion case. Referring to the history of the patents there involved, the Court of Appeals said:

> "* * * certainly in old days that would have told strongly in favor of the patent",

and as to one of the patents there involved, it said:

> "Undoubtedly this would have been held invention in times past but now the climate of opinion has changed to require definite novelty in idea, and not new adaptations of an old idea."

In the case at bar, the Court of Appeals held as to Patent No. 2,128,827, that:

> "Killian is entitled to whatever merit is due to the first person who satisfies a long existing need. Moreover, presumably he designed his machine from the ground up and without suggestion or cue; and we may well agree that, taken as a feat, that displayed enough originality to support a patent." (R. 829.)

Thus, by its own findings, the Court below held that the patent measured up to the test stated by this Court as follows:

"It (the invention) is the result of an inventive act, the birth of an idea and its reduction to practice; the product of original thought; a concept demonstrated to be true by practical application or embodiment in tangible form." (Citing cases) *United States v. Dubilier Condenser Corp.*, 289 U. S. 178, 188.

The present position of the Court below is the result of its repudiation of the very History Test which it helped so greatly to formulate throughout the period from 1908 to 1945 and to which it has frequently said it was committed. The Court below had brought together from many decisions of this Court* the fundamentals of the History Test and tersely stated those fundamentals in *Safety Car Heating and Lighting Co. v. General Electric Co.*, 155 F. (2d) 937, at page 939, as follows:

"In appraising an inventor's contribution to the art, as we have often said, the most reliable test is to look at the situation before and after it appears.

* * * * *

"Courts, * * * had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention. Among these

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* *Goodyear Tire & Rubber Co. Inc. et al. v. Ray-O-Vac Co.*, 321 U. S. 275 and the many cases cited therein;
Hildreth v. Mastoras, 257 U. S. 27;
Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45;
Powers-Kennedy Co. v. Concrete Co., 282 U. S. 175;
Altoona Publix Theatres v. Tri-Ergon Corp., 294 U. S. 477;
Detrola Corp. v. Hazeltine Corp., 313 U. S. 259;
Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84;
Williams Mfg. Co. v. United Shoe Mach. Corp., 316 U. S. 364;
Universal Oil Co. v. Globe Co., 322 U. S. 471;
Dow Chemical Co. v. Haliburton Oil Well Cementing Co., 324 U. S. 320;
Sinclair & Carroll Co. Inc. v. Interchemical Corp., 325 U. S. 327;
Graver Tank & Mfg. Co. Inc. et al. v. Linde Air Products Co., 336 U. S. 271.

> will figure the length of time the art, though needing the invention, went without it: the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it at about the same time, whether before or after: and—perhaps most important of all—the extent to which it superseded what had gone before. We have repeatedly declared that in our judgment this approach is more reliable than *a priori* conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions. (citing many cases.)"

The History Test was recently followed and applied by this Court to uphold a patent in *Goodyear Tire & Rubber Co. v. Ray-O-Vac*, 321 U. S. 275, 278 and 279, where this Court cited with approval many of its prior decisions. The History Test is still the rule being applied to uphold patents in this Court. *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.*, 336 U. S. 271.

It will be a great loss to all concerned if this History Test is not kept in full force and effect. Nothing better has ever been devised or is suggested as a substitute.

The Court below apparently believed that this Court very recently repudiated the History Test. There has been no such repudiation as appears from the following history.

Referring to the History Test, the Court below said as recently as November, 1944:

> "* * * we understand that the Supreme Court still countenances that approach. (Goodyear Tire & Rubber Co. v. Ray-O-Vac, 321 U. S. 275, 278, 279, 64 S. Ct. 593):" *Condenser v. Micamold*, 145 F. (2d) 878, 879.

And so, a few months earlier (August 28, 1944), the Court below had held a patent valid and infringed in the case of *Interchemical Corp. v. Sinclair & Carroll Co., Inc.*, 144 F. (2d) 842. There the Court followed and applied the History Test of invention.

On May 25, 1945, this Court reversed the Court below and held the patent invalid (*Sinclair & Carroll Co., Inc. v.*

Interchemical Corp., 325 U. S. 327). It appears that the reason for that reversal was that this Court accepted the Findings of Fact of the District Court and rejected the reasoning of the Court of Appeals which was incompatible with those findings.

Shortly after that reversal, the majority opinion of the Court below held in *Jungersen v. Baden et al.*, 166 F. (2d) 807, 811, as follows:

> "The elements here stressed by plaintiff were present in even stronger form in some of these cases, as witness our view in Interchemical Corp. v. Sinclair & Carroll Co., 2 Cir., 144 F. 2d 842, and that of the Seventh Circuit in Kalo Inoculant Co. v. Funk Bros. Seed Co., 7 Cir., 161 F. 2d 981, each reversed in the recent Supreme Court decisions just cited. *We should heed the admonition of these reversals.*"

On review of that case (335 U. S. 560, 571) the dissenting opinion of Mr. Justice Frankfurter and Mr. Justice Burton quoted from the dissenting opinion of Judge Learned Hand as follows:

> "* * * I confess myself baffled to know how to proceed, if we are at once to profess to apply the system as it is, and yet in every concrete instance we are to decide as though it did not exist as it is. In the case at bar, I can only say that, so far as I have been able to comprehend those factors which have been held to determine invention, and to which at least lip service continues to be paid, the combination in suit has every hall-mark of a valid patent."

and on page 572, Mr. Justice Jackson in his dissenting opinion said:

> "But I doubt that the remedy for such Patent Office passion for granting patents is an equally strong passion in this court for striking them down so that the only patent that is valid is one which this court has not been able to get its hands on."

That statement of Justice Jackson applies to the Court of Appeals for the Second Circuit, which has stricken down

every patent where validity was in issue that has come before it during the past five years. This Court, however, within two months after Justice Jackson's statement, *unanimously* sustained a patent in the case of *Graver v. Linde,* 336 U. S. 271, 281.* Mr. Justice Black, with whom Mr. Justice Douglass joined, in his concurring opinion, said:

> "I agree, however, that the facts found here justify the holding that Claims 18, 20, 22 and 23 do show patentable discovery when measured by the standards announced by this Court in Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84."

But this *unanimous* decision, *favorable* to a patent and applying the History Test, did not influence the Court below in its interpretation of the standards by which this Court determines the validity of a patent. For, in the instant case, it invalidates patents, which on the standard set in *Graver v. Linde,* should have been upheld.

Evidently the Court below interprets the last two pronouncements of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U. S. 147, and *Crest Specialty v. Trager,* .... U. S. ...., 95 L. Ed. 532 (advance sheets), as *compelling an indiscriminating antipathy to patents* for inventions, good and bad. This is made clear beyond dispute, by the opinion in the companion case of *Youngs Rubber Corporation v. Allied Latex Corporation,* 188 F. (2d) 945, wherein the Court below said:

> "Plaintiff urges that the climate of opinion is again shifting, citing the opinions in Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U. S. 271, 339 U. S. 605. But that case dealt specifically with the question of equivalents to show infringement, and later decisions do not support *the plaintiff's reading of directional signals.* Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., *supra;* Crest specialty v. Trager, ... U. S. ....."

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* This Court has sustained no less than four patents in the past ten years.

The final devitalization of the History Test by the Court below has been accomplished by requiring the inventor, as a *sine qua non* of validity, to prove that a prior patent was "generally" or "widely known in the art."

Litigation-wise, let us look at this proposition from the point of view of the parties and the Trial Court. Are there no limitations to the burden which may be imposed on an inventor who turns to the courts for vindication of his rights?

As shown hereinbefore, that requirement is contrary to the rules and the presumptions in this Court and several Courts of Appeals and is based on a judicial assumption without benefit of proof and contrary to fact, and is fundamentally so unsound that it leads to the absurd result that a patent on a device long used industry-wide may be invalidated by a patent that does not anticipate and is for an inoperative and useless thing.

The Court below professes a solicitude to "heed the admonitions" of a previous reversal. The question is whether the Court has "heeded," or whether it has overreacted at the expense of the present and other parties. We suggest that the latter is the case.

The result of following the impossibly high standards set by the Court below is highlighted by the fact that of approximately *fifty (50) patents adjudicated during the past five years in the Court below, not a single claim of a patent was sustained where validity was contested.* According to the Annual Reports of the Commissioner of Patents during the past ten years, over twenty (20) per cent of all patents granted during that time were issued to residents of New York, Connecticut and Vermont, constituting the jurisdiction of the Second Circuit. *It follows that twenty (20) per cent of all United States patents issued cannot be sustained in the Circuit in which their owners live, and the owners of the other eighty (80) per cent cannot obtain redress from infringers in the Second Circuit.*

Clearly the Court below is warping this Court's most recent decisions into a mandate that compels it to invalidate every patent that comes before it, even such patents as the one recently held valid by unanimous decision of this Court.

CONCLUSION AND PRAYER.

The decision of the Court below will inevitably serve as a precedent, if allowed to stand, will encourage and foster piracy of meritorious inventions, will make it impossible to sustain improvement patents which are specifically provided for in the Statute (35 U. S. C. 31; R. S. 4886) and will destroy the incentive to invent. The decision of the Court, if allowed to stand, will, by judicial edict, *nullify the Patent System in the Second Circuit,* with the result that enforcement of patent property rights in the Second Circuit and probably elsewhere, will become a futility.

Wherefore, your petitioner respectfully prays that a Writ of Certiorari be issued to the Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals for the Second Circuit be reversed, and that petitioner be granted such other and further relief as may be proper.

Respectfully submitted,

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Aug. 17, 1951.

APPENDIX.

35 U. S. C. 31; R. S. 4886. *Inventions patentable.*

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or *any new and useful improvements thereof,* * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212.)

FILED
SEP 20 1951

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

ASHER BLUM,
GEORGE E. MIDDLETON,
New York, New York,
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SUPPLEMENTARY STATEMENT.

OF THE TWO PATENTS involved in this suit, the first, Killian No. 1,605,445, November 2. 1926, the "Bead-Roller Patent", *expired eight years ago on November 2, 1943.* Petitioner says that this patent was held invalid by the Court below (Pet. 4), but petitioner is mistaken. The Court of Appeals expressly refrained from holding the patent invalid, being content to hold it not infringed:

> "Thus it becomes possible to decide this action upon the issue of non-infringement . . . . The judgment will be reversed, and the complaint upon the first patent will be dismissed for non-infringement" (R. 827).

The second patent, Killian No. 2,128,827, August 30, 1938, the "Distributing Patent", was held invalid by the Court below for lack of invention over two prior patents. Thus the Court had no need to pass on and did not pass on the defense of non-infringement which had been vigorously urged.

The expired Bead-Roller Patent had been litigated before and held valid and infringed by machines differing in structure from the respondent's accused machine, but the Distributing Patent, held invalid here, had never been litigated before. Yet petitioner writes (Pet. 5):

> "No manufacturer other than the respondent has infringed upon either of these patents without suffering an injunction after trial."

But respondent has *not* infringed upon the Bead-Roller Patent, and no other manufacturer was ever sued for infringing the Distributing Patent, so there has been no trial after which the imagined infringer could have suffered an injunction.

Petitioner writes (Pet. 4):

> "These two Killian patents cover important steps in the manufacture of thin dipped rubber articles, including prophylactics."

But prophylactics are not mentioned in either patent. Both relate to the manufacture of "thin rubber articles, such as rubber balloons, finger cots, nipples, rubber gloves". The machines and methods of neither patent are particularly designed for the manufacture of prophylactics.

Petitioner charges (Pet. 6) that respondent "appropriated these two inventions", thereby assuming infringement and validity and begging the question. Petitioner goes on to say that there is "no suggestion in the Record that the respondents did any developmental work of their own." Even if this were true—which it is not—it would be immaterial. Respondent was not charged with appropriation of trade-secrets or any other form of unfair competition.

The only issues involved are infringement of the long-expired Bead-Roller Patent and validity and infringement of the hitherto unadjudicated Distributing Patent. There is no conflict with any other court as to either validity or infringement.

SUMMARY OF ARGUMENT.

The long-expired Bead-Roller Patent, the first patent in suit, was held not infringed by the Court of Appeals. Validity was not passed on. The accused machine, whose structure was stipulated, was patterned after an expired patent and so could not infringe. There is no conflict.

The second patent in suit, the Distributing Patent, was held invalid as to the claims in issue. These claims cover broadly a method and machine for making balloons, finger cots, nipples and rubber gloves by dipping a form in a

rubber solution, then removing the form and rotating and oscillating it to evenly distribute the liquid rubber before it dries and sets. Both specification and claims fail to meet the requirement of R. S. 4888. The claims in suit were held invalid by the Court below on the ground that they do not define a patentable invention over two prior patents, one disclosing a method and machine for dipping forms in a rubber solution followed by removal and rotation of the forms to distribute the rubber, and the other disclosing a method and machine for making nipples by dipping forms in a rubber solution followed by removal and oscillation of the forms to distribute the rubber.

In answering petitioner's argument that the industry's failure to modify and utilize the structures of the machines of the two prior art patents was evidence that Killian had made an invention, the Court of Appeals pointed out that there was no evidence that the industry knew of those prior art patents and that such knowledge could not be presumed. This is sound law. Although the inexorable provisions of the statute deny to a patentee a monopoly of what was in the prior art, though unknown to him, so that courts sometimes say that a patentee is presumed to know the prior art, there can be no presumption that any particular patent was known to the industry, and if such knowledge is necessary to a patentee's case, he must prove it.

Petitioner criticizes the Court of Appeals for characterizing the phrase "paper patent" as "a mere bit of rhetoric". But the statute denies a patent to an inventor for an "invention patented or described in a printed publication in this or any foreign country before his invention thereof", and there is no requirement that the thing thus patented or described should have been used commercially.

Petitioner has captiously taken the position that the Court of Appeals has substituted an inventor for the man skilled in the art in the standard test of invention, thereby creating an impossible, new test. This is not so.

The Court of Appeals based its findings of non-infringement of the Bead-Roller Patent on a stipulation and a prior patent, and its finding of invalidity of the Distributing Patent on two prior patents, all of which it was as competent to read and understand as the Trial Court had been. In the opinion of the Court of Appeals, the Trial Court's findings on infringement in the one case and on invention in the other were "clearly erroneous". There was nothing improper or unusual in what the Court of Appeals did, and Rule 52 (a) F. R. C. P. does not forbid reversal under such circumstances.

The so-called "History Test" of invention, which petitioner charges the Court of Appeals with repudiating, is not an absolute test and is resorted to only when other tests are unavailing. That the Court of Appeals for the Second Circuit has sustained no patents in recent years proves nothing with respect to the instant case, but may be an indication that that Court is applying the exacting standard of invention which this Court has latterly required of it and of all other federal courts.

ARGUMENT.

THE BEAD-ROLLER PATENT.

KILLIAN, NO. 1,605,445 (R. 611).

The Bead-Roller Patent relates to "a new and novel means for forming an annular bead on the open ends of rubber balloons, finger cots, nipples, gloves and other tubular articles". Forms are first dipped in a rubber solution to form a thin unvulcanized article and then placed on vertical pins on an endless belt. This belt carries the forms into contact with a rotating, slightly inclined, horizontal brush. It also carries them into contact with a belt which, through frictional contact, rotates the forms. Thus the forms are rotated about their vertical axes as they pass along the brush which rolls up the rubber to form beads or rings on the open ends of the finger cots, etc.

All of the claims in suit call for "a rotatable brush" or the like, with emphasis on the "a". The patentee prescribes a single brush.

The invention of the old patent to Hadfield, No. 1,097,-017, May 19, 1914 (R. 770) "relates to machines for making finger-cots and the like and the object thereof is to provide an improved machine for forming ring-beads on the open ends of the finger-cots", which was precisely the object of Killian's invention. Hadfield discloses (see Fig. 4) two adjustable, rotary beading rollers made of yieldable rubber instead of Killian's single beading brush. At the trial, respondent produced and satisfactorily operated a machine made according to the Hadfield patent. This was not done in any prior litigation. Petitioner does not attack the operability of the machine of the Hadfield patent, as it did in prior litigations.

The construction and operation of respondent's accused beading mechanism was stipulated (R. 650) to be correctly shown and described in respondent's Maywald Patent No. 2,353,256 (R. 661). It will be noted from an inspection of Figures 18 and 19 of this patent (R. 670) that respondent used two beading rollers instead of Killian's single beading brush. At the trial (R. 465) it was conceded that under the stipulation respondent "used two beading rolls side by side until after the expiration of the first Killian patent". Petitioner's counsel conceded (R. 521) that when he inspected the accused machine, both beading rolls were "adjusted fairly close at that time", so that both beading rolls operated simultaneously, exactly as in the prior Hadfield patent.

The Court of Appeals, after considering the disclosure of the Bead-Roller Patent, the stipulated structure of respondent's machine, and the machine of the Hadfield patent, reached the conclusion that if the claims of the Bead-Roller Patent were valid they were not infringed. If respondent's two rollers were the equivalent of Killian's single brush, then respondent infringed, but by the same

token Hadfield anticipated. The Court held that respondent's two rollers were not the equivalent of Killian's single brush, thus leaving the claims valid but not infringed. Respondent having availed itself of the two-roller construction of the long-expired Hadfield patent could not possibly infringe Killian's much later patent. *Scott Paper Co.* v. *Marcalus Co.*, 326 U. S. 249.

It is true that the Bead-Roller Patent had been held valid and infringed in earlier suits, but as the Court of Appeals pointed out: "it so happens that in all the earlier actions the infringers used a single brush" (R. 827). It was this that had distinguished Killian *and* the infringers from Hadfield with his two soft rubber rollers. But respondent like Hadfield, also used two rubber rollers. Thus petitioner finds itself confronted with a dilemma from which there is no escape. "That which infringes if later, anticipates if earlier". *Miller* v. *Eagle Manufacturing Co.*, 151 U. S. 186, 203.

Here we have a long-expired patent which the Court of Appeals, applying old and well established criteria, found not to have been infringed by respondent's machine. There is no conflict; no new questions of law are presented or old ones wrongly decided; and no one other than the immediate parties has the slightest interest in the outcome of the litigation. To ask this Court to review the decision below is to impose upon its time and patience.

THE DISTRIBUTING PATENT.

KILLIAN, NO. 2,128,827. (R. 617).

"This invention relates to the manufacture of articles by what is commonly known as the dipping process * * *." And "it particularly relates to apparatus for completely producing thin dipped rubber articles from liquid latex or rubber cement * * *". The specification then goes on to say that "The invention is particularly adapted for

use in the manufacture of thin rubber articles such as rubber balloons, finger cots, nipples, rubber gloves . . ." (p. 1, col. 1, ls. 1-20).

One of the objects recited is to

> "provide a new apparatus and a new method whereby a very short period of time need be allowed to permit the surplus rubber to drain from the form and which will evenly distribute a large amount of the usual drip over the form thereby providing a coating of greater thickness at each dipping; one dipping being sufficient for articles of ordinary thickness" (p. 1, col. 2, ls. 11-18).

In achieving this object Killian moves his dipped form about, tilting it and rotating it so as to get an even distribution of the rubber on the form before it dries and sets. The machine of the patent comprises an endless conveyor on either side of which are pivotally mounted a series of rotatable forms (see Figs. 1 and 10). The conveyor carries the forms through dipping tanks of rubber solution, and the machine rotates and tilts them.

Much was made in the argument below of the nature of the articles, prophylactics, and their extreme thinness, and the use of latex as distinguished from rubber cement, and this argument seemed to have impressed the District Court. But the patent itself, although relating to the manufacture of thin rubber articles, states quite definitely what is meant by thin rubber articles: "such as rubber balloons, finger cots, nipples, rubber gloves . . .". Prophylactics are not even mentioned. And all through the specification the patent refers to "liquid latex or rubber cement" as obvious equivalents—which they are. Latex is the sap of the rubber tree. It consists of minute globules of rubber suspended in water and when the water is evaporated a residue of dry rubber remains. Rubber cement is rubber dissolved in naphtha. In view of these

facts petitioner's attempt to limit the patent to a particular product, a prophylactic, made from latex must fail. *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560.

As we shall show presently, it had long been known in the art of manufacturing thin rubber articles by the dipping process that, in order to insure the formation of a uniform film and prevent the formation of a thick spot at the end of the article, it was necessary to tilt the form back and forth after dipping. Conceivably, Killian might have discovered the optimum conditions for producing the best results by correlating amplitude and time of oscillation, speed of rotation, quality of the rubber solution, atmospheric conditions and temperature. However, there is not a word in the Killian patent as to the amplitude, frequency and duration of the oscillations, the temperature of the forms, or the viscosity of the rubber cement solution or latex. As for the speed of rotation, Killian says that it would depend upon the nature of the goods (p. 5, col. 2, ls. 53-63).

This ambiguity in the specification is reflected in the claims in suit. Claim 14, for example, reads as follows:

> "That method for making dipped rubber articles directly from liquid latex or the like which comprises passing a form through a body of latex, said form being extended into said body with its axis at an angle to the surface thereof, passing said form out of said body of latex and thereafter simultaneously rotating said form about its axis and oscillating said form between positions in which its axis extends at angles above and below the horizontal until the film of rubber deposited on the form has set."

The apparatus claims are even worse, claim 5, for example reading as follows:

> "In apparatus of the class specified, a conveyor arms projecting therefrom, a form mounting membe

hingedly mounted on each arm and forms secured to said mounting member."

These are among the claims held valid by the District Court and invalid by the Court of Appeals. The Distributing Patent fails to meet the requirements of R. S. 4888.

It had long been known in the art of manufacturing rubber articles by the dipping process that movement of the form after dipping was necessary to distribute the liquid rubber. A Dutch patent, No. 2,002, April 25, 1917 (R. 764), discloses a machine for making rubber balls of latex by means almost identical with those disclosed by Killian. After pointing out the differences in purpose of the two machines, the Court of Appeals went on to say (R. 829):

> "Nevertheless, with one exception they are so far alike that the Dutch machine could have been substituted for the patent in suit after changes that certainly could not of themselves sustain a patent."

The one exception was that Killian added:

> "the feature that, after a 'form' had been dipped in its bath of latex and had been raised back again to horizontal, it was raised, still rotating, above the horizontal, so as to insure a more uniform spread of latex. The Dutch patent did not disclose that step and did not need to, because uniformity of distribution was no part of its aim."

But uniformity of distribution *had* been the aim of one Mitzel who was granted patent No. 1,365,528 on January 11, 1921 (R. 785). Mitzel was making nipples by dipping forms in a bath of rubber solution and then, on removal, inverting and reverting them to secure uniformity of distribution of the liquid rubber, or, as Mitzel put it "to overcome any tendency of the solution to flow downward and mass at an end of the form" (p. 2, col. 1, ls. 34-38).

The Dutch patent disclosed dipping and rotation; Mitzel disclosed dipping and oscillation. As the Court of Appeals said (R. 830):

> "had an inventor, bent on adapting the Dutch machine to the manufacture of 'prophylactics' found that rotation of the 'forms' at horizontal resulted in an uneven thickness, he would have been a curiously sluggish experimenter, if with Mitzel before him, he did not try out the effect of the method Mitzel disclosed.
>
> "The case therefore comes down to this: How much insight was required to observe that the Dutch machine could be used for the new purpose. That insight once achieved, the necessary adaptations were easily within the reach of ordinary perseverance."

In short, the most that Killian did was to modify the Dutch machine, as taught by Mitzel, and use it for a new purpose.

But patents (other than design and plant patents) are granted under the statute, R. S. 4886, only for

> "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof".

A valid patent cannot be granted for a new use of an old machine. Many cases to this effect in various circuits are collected in *Old Town Ribbon & Carbon Co., Inc.* v. *Columbia Ribbon & Carbon Mfg. Co., Inc.*, 159 F. 2d 379, where the Second Circuit, summing up at page 382, states that a new use, "can never be patentable".

Petitioner refers (Pet. 21) to an alleged operation of the Dutch disclosure, citing pages 248-255 and page 812 of the Record. This reference is incorrect. There never was any operation of a model of the Dutch machine. These parts of the record refer to a test of Plaintiff's Exhibit 22,

which is a model of a hand-operated machine resembling the machine of Figure 15 of the Killian Distributing Patent.

PRESUMPTIONS OF KNOWLEDGE OF THE PRIOR ART.

In seeking to avoid the anticipatory effect of Hadfield, the Dutch patent and Mitzel, petitioner, pointed out to the Court of Appeals that none had made any impression on the art. Surely, said petitioner, the art would have utilized the teachings of the Hadfield, Dutch and Mitzel patents if, in fact, those patents had had anything to teach. But the Court of Appeals rejected this argument, pointing out (R. 831) that, although a patentee is chargeable with knowledge of all that had gone before,

> "Yet when he seeks to use the art's failure to anticipate him as evidence of his own perspicacity, he must appraise the art's inaptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware."

The Court said that, in the case of both the Hadfield and the Dutch patents, it should have to be satisfied that they had been widely known in the art before it could credit Killian with an inventor's perspicacity. This is certainly sound law. There is obviously no presumption that an obscure Dutch patent—or any other patent for that matter—was known to the workers in this art. When it comes to a patentee, however, an entirely different situation is presented. Although Courts are fond of saying that a patentee is presumed to know the prior art, this is merely a figure of speech. A patentee's rights are defined by R. S. 4886. He may not patent an invention "patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof,

or more than one year prior to his application". It is quite immaterial that he did not know of these prior patents or publications; hence the alleged "presumption" that he did.

PAPER PATENTS.

The Court of Appeals characterized the phrase "paper patent" as "a mere bit of rhetoric" and "a meaningless platitude" (R. 826, 827). Petitioner claims that by thus destroying the category of "paper patents" the Court below has created a conflict with the Court of Appeals for the Sixth Circuit. Petitioner defines a "paper patent" as "one which discloses a device that has never been used commercially" (Pet. 16). Petitioner may be confusing the anticipatory effect of a prior public use with that of a prior patent, but R. S. 4886 clearly distinguishes between them. The statute denies a patent to an inventor for an invention "patented or described in a printed publication in this or any foreign country, before his invention or discovery thereof". There is no requirement that the thing previously patented or described should have been "used commercially". Neither the Sixth Circuit nor any other has ever held to the contrary.

THE MECHANIC-SKILLED-IN-THE-ART TEST OF INVENTION.

Petitioner claims that the Court of Appeals has substituted another inventor for the man skilled in the art in the old test of invention, and that under this new rule it is "an essential requirement for the validity of a patent that the subject matter display 'more ingenuity than the work of an *inventor*' " (Pet. 18). Petitioner evolves this paradox from a sentence in the opinion below (R. 830) quoted earlier in this brief:

> "Nevertheless, had an inventor, bent on adapting the Dutch machine to the manufacture of 'prophylactics' found that rotation of the 'forms' at horizontal re-

> sulted in an uneven thickness, he would have been a curiously sluggish experimenter, if with Mitzel before him, he did not try out the effect of the method Mitzel disclosed."

It is clear enough that Judge Learned Hand, whose language this is, intended by "inventor" to designate only an "experimenter", as in fact he refers to him later in the quoted sentence. Petitioner is indeed hard pressed for arguments if it must indulge in this sort of quibble.

FINDINGS OF FACT; RULE 52 (a) F. R. C. P.

Like all litigants who have won in the trial court, petitioner holds the findings of that court sacrosanct, relying upon that part of Rule 52 (a) which declares that "Findings of fact shall not be set aside unless clearly erroneous". The Court of Appeals for the Second Circuit is well aware of the rule and understands its meaning. In *Orvis* v. *Higgins,* 180 F. 2d 537, 539, discussing Rule 52 (a) it said:

> "Where a trial judge sits without a jury, the rule varies with the character of the evidence: (a) If he decides a fact issue on written evidence alone, we are as able as he to determine credibility, and so we may disregard his finding. (b) Where the evidence is partly oral and the balance is written or deals with undisputed facts, then we may ignore the trial judge's finding and substitute our own, (1) if the written evidence or some undisputed fact renders the credibility of the oral testimony extremely doubtful, or (2) if the trial judge's finding must rest exclusively on the written evidence or the undisputed facts, so that his evaluation of credibility has no significance. (c) But where the evidence supporting his finding as to any fact issue is entirely oral testimony, we may disturb that finding only in the most unusual circumstances."

The courts of appeals for other circuits have uniformly applied the rule as so defined: that in non-jury cases, where the evidence is largely documentary or physical or not in dispute (as were the patents and the models before the District Court here), as distinguished from conflicting oral testimony, the appellate court is as competent to review and interpret the evidence as was the trial court and is not precluded from so doing by Rule 52 (a).*

Here the Trial Court found that Killian, in his Distributing Patent, had made an invention over the Dutch patent and Mitzel. The Court of Appeals after considering the same documentary evidence found that he had not, obviously concluding that the findings of the Trial Court had been "clearly erroneous". Petitioner relies heavily upon the decision of this Court in *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 which restated the "two-court rule". But later this Court itself in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147 refused to be bound by that rule where it appeared that a less exacting standard of invention had been used by the two courts than that required. Aside from the obvious fact that the two-court rule is not applicable here, it is plain that the Court of Appeals reversed the District Court because the latter had used the wrong standard of invention in finding the claims in suit valid.

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* *Hanovia Chemical & Mfg. Co.* v. *David Buttrick Co.*, 127 F. 2d 888, 891 (1 Cir.).
Kuhn v. *Princess Lida of Thurn & Taxis*, 119 F. 2d 704, 705, 706 (3 Cir.).
Butex Gas Co. v. *Southern Steel Co.*, 123 F. 2d 954, 955 (5 Cir.).
Letcher County v. *De Foe*, 151 F. 2d 987, 990 (6 Cir.).
Sales Affiliates v. *National Mineral Co.*, 172 F. 2d 608, 613 (7 Cir.).
Sbicca-Del Mac v. *Milius Shoe Co.*, 145 F. 2d 389, 395, 396 (8 Cir.).
Home Indemnity Co. of New York v. *Standard Acc. Ins. Co.*, 167 F. 2d 919, 930 (9 Cir.).

In the case of the Bead-Roller Patent the Trial Court found that respondent had followed Killian and not Hadfied and so infringed. This finding was based on a consideration of the two patents and a stipulation as to the construction and operation of the accused machine. The Court of Appeals, with the same documentary evidence before it, found that respondent had followed Hadfield and not Killian and so did not infringe. The reversal was clearly proper under the Rule.

THE HISTORY TEST.

Petitioner concludes its petition with a salute to what it calls the "History Test" of invention, which it says the Court of Appeals has now repudiated. But the history test, or the test of the long-felt want, with its concomitant, commercial success, was never an absolute test and is at best applied only when invention is in doubt. If the Court of Appeals for the Second Circuit has latterly shown less enthusiasm for this test than formerly it is only because of pointed admonitions from this Court. In *Interchemical Corp.* v. *Sinclair & Carroll Co.*, 144 F. 2d 842, cited by petitioner (Pet. 25), the Court of Appeals had applied the test saying (843):

> "We think the record clearly establishes that the trade had long striven to secure an ink that would maintain its consistency on the rollers until the web was imprinted and would then instantly dry on application of a sufficient amount of heat but had never succeeded in obtaining such an ink until Gessler made his invention."

The Court thereupon held the claims in suit valid and infringed, reversing the District Court which had held them invalid and not infringed. This Court granted certiorari and in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327,

335, reversed the Court of Appeals, holding the claims invalid for lack of invention. In short, the history test was unavailing to save a patent when what the patentee had done was "no more ingenious than selecting the last piece to put into the last opening in a jig-saw puzzle". The commercial success of a patented thing is part of its history. Yet only as recently as in *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, 153, this Court reiterated the rule that "commercial success without invention will not make patentability". No, the history test is not wholly reliable.

Petitioner writes (Pet. 27) that:

> "Evidently the Court below interprets the last two pronouncements of this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, and *Crest Specialty* v. *Trager*, —— U. S. ——, 95 L. Ed. 532 (advance sheets) as *compelling an indiscriminating antipathy to patents* for inventions, good and bad."

We submit that the antipathy of the Court below is only for patents for *bad* inventions, that is to say for patents that claim no invention at all. It may be true that the Court of Appeals for the Second Circuit has sustained no patent during the past five years but until we know what the invalidated patents claimed, we can draw no intelligent conclusion from the mere fact of their invalidation. Maybe this Court would have invalidated them too; as a matter of fact, in the only case that went up, *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, it did just that. Even assuming *arguendo* that the Court below has erred in other cases, that cannot concern us here, where the only question involved is whether that Court's decision in the *instant* case warrants this Court's review.

THERE IS NO GOOD REASON WHY THE WRIT SHOULD BE ALLOWED.

This is just another patent suit in which the defeated litigant seeks redress from this Court for no good reason except that it would like to win. One of the patents in suit has long since expired and whether or not it was infringed by respondent is of no possible concern to anyone but the parties to this litigation. The claims in suit of the other patent were held invalid for lack of invention over the prior art. This is the first and only time this patent has been adjudicated. There is no conflict as to either patent and the case presents no questions requiring answer by this Court.

THE PETITION FOR A WRIT OF CERTIORARI SHOULD BE DENIED.

Respectfully,

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September 17, 1951.

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CHARLES

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 256.

FRANK B. KILLIAN & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION AND HOWARD G. STRAUSS,

Respondents.

PETITIONER'S REPLY

to

Respondents' Brief Opposing Petition for Rehearing of Order Denying Petition for Writ of Certiorari.

BLYTHE D. WATTS,
MORRIS HIRSCH,
Counsel for Petitioner.

GEORGE H. DESSION,
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THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 1-5647

In the Supreme Court of the United States

OCTOBER TERM, 1951.

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FRANK B. KILLIAN & COMPANY,

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Respondents.

PETITIONER'S REPLY

to

Respondents' Brief Opposing Petition for Rehearing of Order Denying Petition for Writ of Certiorari.

It is not true, as stated on page 2 of respondents' brief, that petitioner "bases its whole petition" on the Court of Appeals' statement quoted by respondents. Page 2 of the Petition for Rehearing asserted that the Court below had held the patents invalid because petitioner had not proved that the prior patents were "widely known in the art" and referred to pages 7, 10 and 12-15 of the Petition for Writ where that ground was set out at greater length.

Respondents' attempted distinction between this case and the case of *Landis Mach. Co. et al. v. Parker-Kalon Corp. et al.*, 190 F. (2d) 543 is also incorrect. Respondents say that in the latter case the Court of Appeals "had expressed some doubt as to the validity of the claims in suit" but that in the instant case the Court entertained "no doubt on the score of invalidity." The language used by the Court in these two cases discloses respondents' error in this regard.

In the *Landis* case the Court said at page 547:

"All that was needed was, either some acquaintance in detail with Hanson, or more persistence in experimenting to overcome what Reimschissel too readily assumed to be an insurmountable obstacle. For these reasons we are not satisfied that the claims in suit are valid; indeed on this record we think them invalid."

In the instant case the Court said at page 831:

"All that was needed was to stop the repetition of the 'process' of imposing 'layer upon layer of latex' at the right thickness. * * * As in the case of Hadfield's patent, we should have to be satisfied that the Dutch machine had been widely known in the art; a most unlikely possibility."

No two peas are more nearly alike.

Respondents would like to forget that the Trial Court had no doubt as to validity; and that the Court of Appeals could find nothing wrong with the Trial Court's findings of fact and simply ignored them, in violation of Rule 52 (a) while creating a new rule on which to base the decision of invalidity.

Petitioner insists that the ground cited in the Petition for Rehearing was a ground *not previously presented.* The previously presented grounds were conflicts between different Courts of Appeals on the same matter (Petition, pp. 6, 7 and 16) and the substitution of "an inventor" for the "mechanic skilled in the art," a variation of Rule 52 (a) and disregard of the history test (Petition, pp. 18, 20 and 23). None of those grounds was even remotely like the ground presented in the Petition for Rehearing.

Respondents' assertion that the present ground was previously asserted is evidently based on a failure to distinguish between a new ground and evidence supporting

a ground. Obviously the same facts may support more than one ground.

The Petition for Rehearing should be granted.

Respectfully submitted,

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MORRIS HIRSCH,
Counsel for Petitioner.

GEORGE H. DESSION,
Of Counsel.

Dated: Cleveland, Ohio,
Nov. 21, 1951.

OCT 5 1951
CHARLES ELMORE

In the Supreme Court of the United States

OCTOBER TERM, 1951.

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FRANK B. KILLIAN & COMPANY,
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ALLIED LATEX CORPORATION, and
HOWARD G. STRAUSS,
Respondents.

PETITIONER'S REPLY BRIEF.

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THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 1-5647

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Respondents.

PETITIONER'S REPLY BRIEF.

We shall here follow the headings under "Arguments" in respondent's brief and for convenient reference, we point out under each heading the pages throughout respondents' brief to which this reply is addressed.

The Bead Roller Patent Killian No. 1,605,445 (R. 611).
(Respondents Br. 1-6.)

Respondents argue that because the Bead Roller Patent has since expired, this Court should not be asked to resolve the irreconcilable conflict between the Eighth Circuit decision in 1939 and the Second Circuit decision in 1951 (Pet. 6-10).

But the issue is much broader than the particular patent here involved.

The novel issue is whether a patent previously in litigation and that had never been declared invalid may properly be devitalized by depriving it of all range of equivalents in the Second Circuit in the face of the holding of the

Eighth Circuit that it is entitled to "a broad range of equivalents approaching that accorded to a pioneer invention."

This Court's ruling on that issue will bear on every litigation hereafter that involves an unexpired patent which had previously been adjudicated valid in one or more United States Courts of Appeals.

The Court below offers a lengthy explanation in an effort to reconcile its present decision unfavorable to the Bead Roller Patent with its previous decision holding that same patent valid and infringed in *Stevens v. Carl Schmid, Inc.*, 73 F. (2d) 54.

Because the machine built according to the teachings of the Hadfield patent was worthless and inoperative, therefore it does not follow, says the Court below (R. 825), that the Hadfield *patent* fails to teach how a commercially useful machine could have been made, despite the fact that Hadfield himself was unable to make such machine work. The Court below says without warrant, that it had committed the logical fallacy of *non sequitur* in the *Stevens v. Schmid* case by failing to consider the Hadfield patent as such apart from any machine built thereunder.

But the Court of Appeals for the Eighth Circuit in its decision (*Dean Rubber Mfg. Co. v. Killian*, 106 F. (2d) 316) *did not even mention any Hadfield machine*, and yet held the same Killian Bead Roller Patent valid and infringed over the Hadfield patent *as such*, stating at p. 320:

> "* * * but that no one prior to Killian, had succeeded in producing such a machine, and even if regarded as no more than an improvement patent, it has demonstrated its worth and importance to such an extent as to entitle it to a broad range of equivalents approaching that accorded to a pioneer invention."

Respondents say (p. 5):

"At the trial, respondent produced and satisfactorily operated a machine made according to the Hadfield patent. This was not done in any prior litigation. Petitioner does not attack the operability of the machine of the Hadfield patent, as it did in prior litigations."

That statement is erroneous. The machine here referred to was *not* according to the Hadfield patent. While had two rollers, these were not so arranged that both ould engage the form simultaneously as Hadfield prescribed. It was according to the *Killian* patent in which nly one roller functioned. Respondents put a second, utterly useless, roller on a Killian patented bead roller and alled it a Hadfield machine. Respondents' expert admitted hat the demonstration machine, which was said to exemlify the machine of the Hadfield patent, differed in many articulars from the Hadfield patent (R. 516-518, 523-527). udge Bondy saw through this subterfuge and held, "one f the rollers of defendants' accused devices is functionless" * * "The accused machines follow Killian and not Hadeld" (R. 808).

The Court below holds the differences between Hadeld's adjudicated failure and Killian's adjudicated success, "trivialities of design," with the one qualification, "unless we consider the elimination of one of the two brushes" R. 825). But the decision goes on to state that "as a new uestion we could not support a patent upon the omission f one of Hadfield's two" (R. 827).

In the face of this clear ruling adverse to validity, respondents yet insist that the Court below had "refrained rom holding the patent invalid" (p. 1), that "validity was ot passed on" (p. 2). On such technicality respondents eek to reconcile hopelessly irreconcilable decisions.

But assuming with respondents that validity had not been passed upon in the decision below, then the previous holdings of validity in both the Second and Eighth Circuits must perforce still control.

The patent thus remaining valid, a holding of infringement necessarily follows. The doctrine of equivalents need not even be invoked, for the claims read literally as well as in spirit on respondents' bead roller. Respondents state (p. 5) that "All of the claims in suit call for 'a rotatable brush' or the like, *with emphasis on the 'a'.*" * We are unable to find, and respondents fail to suggest, where it finds such emphasis. The addition of "a second brush or the like" by respondents does not detract from the fact that respondents nevertheless have "*a* rotatable brush or the like." Infringement is not avoided by adding a second roller, especially where, as here, that roller is functionless as held by the Trial Court, and mere window dressing or camouflage.

In arguing (p. 2) that respondents followed Hadfield, respondents are assuming that both rollers of respondents actually functioned simultaneously, so that one of them was not *functionless* contrary to the finding of the Trial Court. There is no escape from infringement. *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U. S. 605 (Pet. p. 9).

Whether the Court below has now held the Bead Roller patent invalid, as to all intents and purposes it has done, or whether it has technically refrained from so holding, the fact remains that the Court below in depriving the patent of all range of equivalents is in irreconcilable conflict with the Court of Appeals for the Eighth Circuit, which held that it was entitled to a broad range approaching that accorded to a pioneer invention.

---

* Emphasis ours throughout this brief.

The Distributing Patent Killian No. 2,128,827 (R. 617).

(Respondents Br. 1-4, 6-11.)

The Court below held and respondents do not disagree (p. 10) that the Dutch patent was for a purpose "widely different" from that of the patent in suit. Assuming the necessary "insight" on the part of "an inventor" as to its applicability to the purpose of the patent in suit and his ability in the light of his "insight" to make the reorganizations that the Court below enumerates (R. 829), still further reorganization would be necessary as we pointed out (Pet. 21) and without contradiction. Moreover it would be necessary as the Court below found, to look elsewhere for the vital suggestion of oscillating the forms. This suggestion allegedly is found in Mitzel patent 1,365,528.

Respondents' argument that it is so found, is refuted by uncontroverted testimony as to Mitzel on the part of the experts on both sides. Respondents' expert testified:

> "Q. Now, in Mitzel, do you know of any instance where a machine was built like is shown in that patent and used?
>
> A. No, I do not.
>
> Q. There again you do not have rotation or oscillation of the forms, do you?
>
> A. No, sir." (R. 533.)

And petitioner's expert testifies to the same effect that the Mitzel patent shows "no rotation or oscillation" (R. 592).

Respondents are right (pp. 7, 8) that the advantages of the Distributing Patent may be availed of as disclosed, not only with the latex that is more commonly used today, but with cement rubber as well, which was universally

used before refined latex became available in the United States. That cannot be said for the Mitzel patent, since petitioner's expert testifies without contradiction:

> "I have tested the motions shown in the Mitzel patent on demonstration unit 22, and if we dip vertically, then hold it in vertical position for a while, and then reverse the form, as the motion of the belt shows to the vertical upward and keep on doing that progressively, what we get is, while the form has its closed end downward, latex is dripping off the form. While we have the form tilted with its closed end upward, the latex is running down the form in an irregular manner." (R. 592, 3.)

Since the old Mitzel patent cannot be used for latex, it could not possibly be useful to one working with the crude latex machine of the still older Dutch patent. This is wholly aside from the fact that Mitzel does not show or suggest the oscillation as the experts for both parties agree.

In the course of the trial Judge Bondy refutes respondents' allegation (p. 10) that the inoperativeness of the Dutch patent with its stick always horizontal when outside the dipping tank, had not been demonstrated in Court. That appears from the following colloquy:

> "Mr. Blum: Will you stipulate that in the Dutch patent machine that when that form was rotated about its horizontal axis, it secured a uniform circumferential distribution of the latex?
>
> Mr. Watts: A thick ring around the intersection of the semi-spherical part and the circumferential. We demonstrated it with this form.
>
> The Court: That he himself (Mr. Blum) established. He established with latex, it does just those things." (R. 559)

The demonstration Judge Bondy referred to had been summarized by petitioner's expert by stating that the film right near the tip "is wearing into the underlying film and developing a thin spot which will eventually wind up as a flaw or even a hole." (R. 251.)

In the face of the demonstrated worthlessness of any product attained by the Dutch patent, even assuming the necessary "insight" and the necessary reorganization required (without the aid of Mitzel), the resultant product was demonstrated to be utterly worthless and *so found as a fact* by the Trial Court (R. 812). Since as we have shown, Mitzel does not and could not suggest the further change required in the Dutch patent to transform it into a useful machine for the purposes of petitioner and respondents, the soundness of the Trial Court's decision is manifest.

Infringement.

The Trial Court holds that respondents had infringed both patents, and awarded an injunction after trial. Only respondents ever infringed the Distributing Patent. The rest of the industry respected it at all times. Many courts have previously awarded injunctions for infringement of the Bead Roller Patent. The statement quoted (p. 1) from Pet. 5 is therefore strictly in accordance with the fact.

The Court below did not reverse or modify the Trial Court's finding of infringement as to the Distributing Patent, and its reversal as to the Bead Roller Patent was merely *pro forma* (p. 13). Infringement is therefore not a mere assumption and petitioner does not beg the question as stated by respondents (p. 2).

The expression "other tubular articles" which respondents exclude (p. 2) and include in the quotation

(p. 4) euphemistically defines prophylactics. Respondents' statement (p. 2) that the machine and method of neither patent relate particularly to the manufacture of prophylactics is refuted by uncontradicted proof that the entire prophylactic industry paid royalty for their use from the outset, indeed even before the patents were actually granted (Pet. 5). Respondents likewise salute the patents in suit by using their teachings for making prophylactics and by waging costly litigation to defend their infringement.

There is no reference in the record to support respondents' assertion (p. 2) that they had done any developmental work. As stated by this Court in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U. S. 605, 612:

> "Without some explanation or indication that Lincolnweld was developed by independent research, the trial court could properly infer that the accused flux is the result of imitation rather than experimentation or invention."

Presumptions of Knowledge of the Prior Art.

(Respondents' Br. 3, 11-12.)

Respondents (p. 11) fail to answer or even comment upon the showing (Pet. 7, 12 to 15) of *direct conflict* with the Seventh Circuit on the issue of whether it is presumed that knowledge of the prior art was possessed by workers in the art other than the inventor.

Finding that no other Court agrees with the Court below, respondents make the bald assertion that the Court below was right in holding that workers in the art must be presumed to be ignorant of the entire patent literature in their field, and says that "is sound law" (p 7), indeed "is certainly sound law" (p. 11). It is *not* sound law, for

this Court has held to the contrary in *Sontag Chain Stores Co., Ltd. v. National Nut Company of California*, 310 U. S. 281, 295, as follows:

> "All patents must 'be recorded, together with the specifications, in the Patent Office in books to be kept for that purpose.' U. S. C. Title 35, Sec. 39. Constructive notice of their existence goes thus to all the world. *Boyden v. Burke* (1852) 14 How. 575, 582; *Wine Ry. Appliance Co. v. Enterprise Ry. Equipment Co.* (1936) 297 U. S. 387, 393; Walker on Patents, Deller's edition (1937) Vol. 3, p. 2176. In consequence the owner of the machine here accused operated it with implied knowledge of the original patent and may justly claim whatever privileges would follow actual knowledge."

Paper Patents.

(Respondents' Brief 3, 12.)

Respondents (p. 12) have patently evaded discussion of this issue.

Petitioner (p. 16) is in accord with respondents (p. 12) that a "paper" patent which "precisely discloses the purpose, means and mechanism for accomplishing the end of a patent in suit," and is fairly described by the claims of the latter, constitutes an anticipation which is just as effective as if it had not been "still born" and as if it had had an extensive commercial history.

However, as appears in the quotation (Pet. 16), a patent on an organization *not* conceived, disclosed, adaptable by obvious or well-known mechanical expedients, or, in fact, adapted to accomplish the end of the patent in suit may not be reorganized into something that is suggested only by the patent in suit. An argumentative invalidation upon a "still born" patent, as by the Court

below in the instant case, is not countenanced under the Paper Patent Rule. By its decision and by its holding that the "phrase 'paper patent' is a mere bit of rhetoric, * * * a meaningless platitude." the Court below is in direct and irreconcilable conflict with the Sixth Circuit.

Respondents have commented only on that which is not in controversy and have evaded and left unanswered and therefore agree with petitioner that the conflict exists between the Sixth and Second Circuits. *No reason has therefore been advanced by respondents why the conflict should not be resolved.*

The Mechanic-Skilled-in-the-Art Test of Invention.

(Respondents' Br. 3, 12-13.)

Respondents' answer to petitioner's contention on this subject (Pet. 18-19) is that Judge Learned Hand intended by using the word "inventor" to designate only "an experimenter." The Judge has been famous, long and justly, for his ability in using the English language to say exactly what he means. It would be out of character for him to say "inventor" when he meant "experimenter." Respondents evidently overlooked the fact, pointed out (Pet. 19) that the Judge used the word "inventor" not once but twice (R. 830). It seems quite improbable that other Courts, well knowing the Judge's ability correctly and forcefully to use the English language to express his thought, would read the portions of the decision here under discussion as respondents would have them read.

Findings of Fact; Rule 52(a) F. R. C. P.

(Respondents' Br. 4, 13-15.)

Respondents argue (pp. 13 to 15) that the appellate courts are as capable as is the trial court in reading both the patent in suit and the prior patents and determining to what extent there is or is not anticipation. Therefore, respondents contend, the appellate court can make its decision without regard to what was testified by the experts. But if that be so then trials in a patent case would always be futile where, as here, the prior art is confined to earlier patents as distinguished from prior uses.

Respondents evade this subject (Pet. 20-23) by citing decisions which hold, under an exception to this rule, that the reviewing tribunal is not bound by the findings of fact of the trial court where the evidence is documentary or uncontradicted. The rule and its exception are well stated in one of the decisions cited by respondents, namely *Hanovia Chemical & Mfg. Co. v. David Buttrick Co.*, 127 F. (2d) 888, 890-1 (C. A. 1) as follows:

> "Confusing and illogical as it seems, what the courts have done is to find a practical solution for a practical problem. In so far as the answer to the question of patentable invention hinges upon findings with respect to obscure or disputed issues calling for expert testimony either as to the nature of the device patented or as to the nature of the devices of the prior art, the view of the District Judge, who saw the experts on the stand, heard them testify and had the opportunity to ask them questions, is entitled to great weight and we should not venture to disagree with his view as to what these things are unless we are convinced that in some respect he has fallen into clear error. Rule 52(a) F. R. C. P. But on the other hand, when we can clearly comprehend from the record and the exhibits the nature both of the thing

> patented and of the things of the prior art, that is, when the facts are simple and we have as good access to the source of facts as the court below had, we are in as good a position as that court to compare the thing patented with the prior art, as well as to say whether or not the thing patented should be called an invention."

The Court below did not base its decision on documentary evidence of which there is little or none in the case. On the contrary, as the decision clearly shows, the Court indulged in endless speculation including the reasons why the Hadfield machine was not used for many years, the importance of the various parts of that machine, the effect of omitting some of those parts, the operation of the Mitzel and Dutch machines, what an inventor would do to make the Killian invention and how a good prophylactic could be made by using the Dutch machine. Many of these speculations were directly contrary to the record.

For other and even more important reasons this case must remain within the general rule. Here, moving pictures were shown. Models of several machines were exhibited, testified to, and operated in open Court. Demonstrations of the operation of the patented, infringing and prior art machines were also made in open Court. Extensive conflicting testimony was given by experts and also by fact witnesses as to the construction and operation of the infringing machines as well as the machines shown in the prior art. The Trial Court was called upon to determine the credibility of the witnesses and to resolve conflicts in testimony. He had opportunity to, and did, ask the witnesses many questions. On none of these points was the Court of Appeals in as good position as the Trial Court to say whether the patents were valid and infringed.

There was no documentary evidence other than the patents themselves, bearing on the operativeness of the Hadfield, Mitzel or Dutch patents. As to the Hadfield patent, there were the several prior decisions holding that the machine of that patent was inoperative to roll beads commercially. As to the Mitzel patent, both experts and respondents' counsel agreed that there was neither rotation nor oscillation of the forms (R. 533, 592), and no denial of the proof by petitioner's expert that the Mitzel machine could not be used with latex (*supra*, p. 5). As to the Dutch patent there is much uncontradicted testimony in the record showing that the machine of that patent could not do either what it was supposed to do (R. 583-585) or what the Killian distributing machine has done commercially for so many years (R. 586-588).

All these factors keep this case squarely within Rule 52(a) F. R. C. P. as stated by this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 275 (Pet. 20) and as stated in the foregoing case of *Hanovia v. Buttrick.*

The History Test (Pet. 23).

Respondents (p. 15) caricature the history test by suggesting that it amounts only to commercial success and by saying that it "is at best applied only when invention is in doubt." Commercial success is merely one of the many facets making up the well-known history test.

In applying the History Test there must of course be taken into account every material factor of history, both those that support and those that tend to negative the conclusion of invention. In the case of *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U. S. 327 (Respondents' Br. pp. 15, 16), this Court reversed the Court of Appeals for the

Second Circuit, not because it had relied on the History Test, but because in that reliance, the Court below had disregarded important and significant facts of history found by the Trial Court and that are mentioned in this Court's opinion. Thus, when Gessler was asked to make an odorless ink in 1930 (p. 331), he did so without long and difficult experimentation, by simply selecting solvents of appropriate characteristics from a catalogue of a chemical manufacturer. The resultant ink, however, was useless, because while the ink would not dry on the rollers at room temperature, it would not dry on the paper either. But when some years later, Gessler was told that a heating device would be applied to the printing press, he immediately recognized that the ink which he had previously so readily prepared, would be heat dried upon the paper and would therefore serve its intended purpose. On that factor of history which the Court below had disregarded, invalidity was plain.

But in the instant case all the affirmative elements of the History Test are present and there is not a single element which mitigates against the conclusion that an authentic invention had been made.

As we have shown, the Killian patents are so hardy in character that the Court below found it necessary to fashion new engines of destruction in the form of unprecedented rules effective to annihilate any and every patent. The use of these unprecedented rules is the basis of our Petition (Pet. 12 to 19).

CONCLUSION.

We submit that respondents' brief has advanced no reason why this Court should not grant the Petition.

Respectfully submitted,

BLYTHE D. WATTS,
MORRIS HIRSCH,
Counsel for Petitioner.

GEORGE H. DESSION,
Of Counsel.

October 4, 1951.

In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 288.

FRANK H. STELLAR & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION AND HOWARD C. STRAUSS,

Respondents.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Bayard D. Watts,
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THE BYRON S. ADAMS PRINTING CO., WASHINGTON, D. C.—SEPT. 1941

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 256.

FRANK B. KILLIAN & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION AND HOWARD G. STRAUSS,

Respondents.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Petitioner prays that this Court grant rehearing of its Order of October 22d, 1951, denying the Petition for Writ of Certiorari, and that a Writ issue to review the Judgment of the Court of Appeals for the Second Circuit in the above cause, as prayed for in the Petition filed August 20, 1951.

REASON FOR GRANTING REHEARING.

A substantial ground available to petitioner but not previously presented is that

PETITIONER WAS DENIED DUE PROCESS OF LAW BY THE COURT BELOW.

The practical effect of the judgment of the Court below is to deprive the petitioner of property without affording petitioner an opportunity to be heard in its defense.

The patents here are very valuable as is shown by a few record facts. They made it possible to manufacture

and sell prophylactics at the same price for 19 years (R. 50-51) while the costs of the machines were increasing six-fold (R. 49-50) and labor costs were tripling (R. 48-9). Licensees paid royalties at the rate of ten cents (10¢) per gross on goods produced by these inventions (R. 40). During the years of the Second World War, the licensees produced over four million (4,000,000) gross of prophylactics annually (R. 33). The Armed Services of the United States purchased tremendous quantities of these goods for the prevention of disease and these goods were also used for many other purposes (R. 108). Recognizing their value in preventing transmission of disease, another branch of the United States government, through enforcement of the Federal Food Drug & Cosmetics Act (21 U. S. C. 301, *et seq.*) prevents the sale of these goods which are defective as is fully brought out in the companion case of *Youngs Rubber Corp. v. Allied Latex Corp.*, 188 F. (2d) 945, in which a petition for rehearing is being filed concurrently herewith.

As has been pointed out (Pet. pp. 7, 10, 12-15), the Court below held the patents invalid because petitioner had not proved that certain prior patents were "widely known in the art" (R. 831). Although this was a new rule which the Court had created *after argument of the case*, the Court denied petitioner's motion for remand to the District Court to afford an opportunity for presentation of proof of the character required by the new rule. Thus the Court below destroyed valuable property rights while refusing petitioner an opportunity to protect them.

Indeed the Court below has since implicitly admitted not only the novelty of this rule but also the injustice of denying petitioner's motion to remand. For within three months thereafter, the Court cited the new rule in another case and then, *of its own motion*, remanded the case to

afford the patentee an opportunity to adduce evidence required by the new rule. We have reference to *Landis Machine Co. et al. v. Parker-Kalon Corp. et al.*, 190 F. (2d) 543, 547, wherein the Court said:

> "* * * we are not satisfied that the claims in suit are valid; indeed on this record we think them invalid. *Yet it is fair to send back the cause for a new trial on the issue of validity where it can be presented in some such way as we have indicated.* The plaintiffs may be able to show that Heim and Hanson were well known to the art for a substantial part of the seven years after 1927; they may also be able to show that such a combination would always have been welcomed; and in support of that conclusion to show that the art has adopted it very widely to the exclusion of existing methods. In such a setting our doubts arising from our a priori decision that the combination was not patentable, may disappear. We will not now prejudge the decision of the district court by any present intimations; but we do hold that on the record before us the judgment must be reversed and the cause remanded for a new trial on the issue of validity." (Emphasis is ours.)

Under circumstances similar to those existing here, this Court reversed the Supreme Court of Missouri on the ground that such circumstances constituted denial of the due process of law guaranteed by the Fifth and Fourteenth Amendments to the Constitution. In *Brinkerhoff-Faris Trust and Savings Co. v. Hill*, 281 U. S. 673, this Court said:

> "The plaintiff seasonably filed a petition for a rehearing in which it * * * asserted * * * that * * * in refusing relief because of the newly found powers of the commission, the court transgressed the due process clause of the 14th Amendment. * * * The petition was denied without opinion. This court

> granted certiorari, 280 U. S. 550, ante, 608, 50 S. Ct. Rep. 162. We are of opinion that the judgment of the Supreme Court of Missouri must be reversed, because it has denied to the plaintiff due process of law—using that term in its primary sense of an opportunity to be heard and to defend its substantive right." (pp. 677, 678.)

In that case, as here, the denial of due process of law was accomplished by the judiciary. Nevertheless this Court held as follows:

> "The federal guaranty of due process extends to state action through its judicial, as well as through its legislative, executive or administrative branch of Government." (p. 680.)

This Court went on to point out that its concern was "solely with the question whether the plaintiff has been accorded due process in the primary sense,—whether it has had an opportunity to present its case and be heard in its support" (p. 681). The Court below in the present case had no more right, than did the Supreme Court of Missouri in the above quoted case, to "deprive a person of all existing remedies for the enforcement of a right," unless he was afforded "some real opportunity to protect it" (p. 682).

CONCLUSION.

For the foregoing reasons, petitioner respectfully submits that this petition for rehearing should be granted and that a writ of certiorari should issue to the Court of Appeals for the Second Circuit.

In focusing this petition for rehearing on the denial of procedural due process, petitioner in no sense abandons its earlier contentions. However, since the foregoing new rule was the primary, if not sole, basis for the decision of the

Court below, petitioner's property rights would be adequately protected by the rejection of that rule by this Court. In that event it would be appropriate for this Court to reverse the Court below and reinstate the judgment of the District Court without remanding the case for a new trial on the issue of validity.

Respectfully submitted,

BLYTHE D. WATTS,
MORRIS HIRSCH,
Attorneys for Petitioner.

GEORGE H. DESSION,
Of Counsel.

Certificate of Counsel.

I hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 33 of the Rules of this Court.

BLYTHE D. WATTS,
Counsel for Petitioner.

Dated: Cleveland, Ohio,
Nov. 5, 1951.

28

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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

RESPONSE TO PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Invoking the Fifth and Fourteenth Amendments to the Constitution, petitioner claims that it has been deprived of property without due process of law. The property of which petitioner claims to have been unlawfully deprived consists of the two patents in suit, which petitioner still insists were held invalid by the Court of Appeals. But as pointed out on page 1 of our brief in opposition to the petition for certiorari, the first patent in suit, the one that expired eight years ago this month, was *not* held invalid. The Court of Appeals found that respondent was following the prior art and so did not infringe. It is difficult to find any deprivation of property here. The second patent in suit was held invalid for lack of invention over two prior patents. If the petitioner here was deprived of his patent property without due process of law, then every patentee whose patent is held invalid is similarly deprived, and R. S. 4920 is unconstitutional. Yet no court has ever so held.

Petitioner bases its whole petition for rehearing on the Court of Appeals' statement (R. 831) that an inventor

> "* * * when he seeks to use the art's failure to anticipate him as evidence of his own perspicacity, * * * must appraise the art's ineptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware."

Petitioner characterizes this as a new rule and complains that the Court's denial of its motion for remand to the district court "to afford an opportunity for presentation of proof of the character required by the new rule" destroyed valuable property rights. Petitioner complains that in a later case, *Landis Mach. Co. et al.* v. *Parker-Kalon Corp. et al.,* 190 F. 2d 543, the Court of Appeals did remand, and should have done so here. In the *Landis Mach Co.,* case, however, the Court of Appeals had expressed some doubt as to the validity of the claims in suit and felt that further evidence might resolve that doubt. In the instant case, on the contrary, the Court entertained no doubt on the score of invalidity and so properly refused to remand. The matter was one clearly within its discretion.

In *Brinkerhoff-Faris Trust & Savings Co.* v. *Hill,* 281 U. S. 673, a tax case, the complaint was dismissed by the highest state court solely on the ground that the plaintiff had an adequate legal remedy before a state tax commission, and that the plaintiff was not entitled to equitable relief, because of laches in failing to proceed before the commission. The highest state court had previously held that the commission had no power to decide the tax question. The result was that plaintiff was thrown out of court without a hearing. That is not the situation here.

Rule 33, 2. of this Court confines the grounds on which a petition for rehearing may be filed "to intervening cir-

cumstances of substantial or controlling effect, or to other substantial grounds available to petitioner although not previously presented". Petitioner alleges the latter. But the ground now asserted was previously asserted on pages 12 through 15 of the petition for certiorari. Petitioner is advancing the same old argument decked out in a new garb.

THE PETITION FOR REHEARING IS DEVOID OF MERIT AND SHOULD BE DENIED.

Respectfully,

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November 12, 1951.

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IN THE

Supreme Court of the United States

October Term, 1951.
No. 256.

FRANK B. KILLIAN & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,

Respondents.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari and Supporting Brief.

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IN THE

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October Term, 1951.
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FRANK B. KILLIAN & COMPANY,

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vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,

Respondents.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Comes now J. Calvin Brown, of the Bar of the United States Supreme Court, and respectfully petitions for leave to file a brief *amicus curiae* on the grounds:

(1) that the decision of the United States Court of Appeals for the Second Circuit in the above-entitled case formulates new rules for invalidating patents, which rules are contrary to those applied by this Court and by other Courts of Appeals and which vitally affect the patent system, and

(2) that these newly formulated rules are matters of great public interest and importance to inventors, patent owners and all members of the public who make, use or sell patented articles.

Petitioner, *amicus curiae,* is National President of The American Society of Mechanical Engineers, and feels that he would be remiss in his duty if he did not file this petition on behalf of the engineering profession generally and their clients.

The brief for which leave to file is hereby requested accompanies this Petition.

This Petition is presented in good faith and is filed solely in what is believed to be the public interest. Petitioner does not represent any of the parties hereto nor has he any interest in the specific subject matter of the suit.

J. CALVIN BROWN,
Petitioner, Amicus Curiae.

IN THE

Supreme Court of the United States

October Term, 1951.
No. 256.

FRANK B. KILLIAN & COMPANY,

Petitioner,

vs.

ALLIED LATEX CORPORATION, and HOWARD G. STRAUSS,

Respondents.

Brief Amicus Curiae on Petition for Writ of Certiorari.

The new rules formulated by the Court of Appeals in the present case appear to strike at the very vitals of the entire patent system. If allowed to stand and serve as precedent they will nullify the patent statutes by making it impossible to sustain a patent.

The Court of Appeals sets up the following unprecedented tests:

(1) Only if the teaching of the patent in suit displays a greater skill than that of an *inventor* (rather than that of a mechanic skilled in the art) can the patent be valid.

(2) A prior, non-anticipating patent may invalidate a patent for lack of invention, unless the plaintiff proves that the prior patent had been generally or widely known in the art.

(1) The present rule for distinguishing invention from mechanical skill was recently restated by this Court as follows:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity * * * than the work of a mechanic skilled in the art.'" (Citing many cases.)
>
> *Sinclair & Carroll Co. v. Interchemical Corporation,* 325 U. S. 327, 330.

The decision of the Court of Appeals in the instant case (188 F. 2d 940), has replaced the "mechanic skilled in the art" of that rule by *an inventor,* so that the rule as so modified requires a patent to show more ingenuity than the work of an inventor. The Court of Appeals held as follows 188 F. 2d 940 at page 944:

> "Nevertheless, had *an inventor,** bent on adapting the Dutch machine to the manufacture of 'prophylactics' found that rotation of the 'forms' at horizontal resulted in an uneven thickness, he would have been a curiously sluggish experimenter, if with Mitzel before him, he did not try out the effect of the method Mitzel disclosed. * * * We cannot agree that, if *an inventor* wished to supply the market with such articles and had the Dutch disclosure before him, this step demanded that degree of exceptional endowment which—especially in recent years—is necessary to support a patent."

It is clear that no patent can be valid if its subject matter must display more ingenuity than the work of *an inventor.*

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*Emphasis supplied.

It is submitted that the prevailing rule in this Court should continue to be the rule and that the modification of that rule by the Court of Appeals should be overruled.

(2) The Court of Appeals held as follows at page 944:

> "Yet when he seeks to use the art's failure to anticipate him as evidence of his own perspicacity, he must appraise the art's ineptitude by the art's actual knowledge; he may not impute to it an acquaintance with any part of what went before of which it was not aware."

Other courts of coordinate jurisdiction have held to the contrary that everyone is chargeable with knowledge of the prior patented art, from the date of its grant.

E. R. Wagner Mfg. Co., et al. v. Porter Steel Specialties, 116 F. 2d 63 (C. A. 7);

In re Coey & Peterson, 90 U. S. P. Q. 216, 219 (C. C. P. A.).

The rule that an inventor is chargeable with knowledge of the prior art and the general public is not so chargeable could lead to the anomalous situation in which an inventor could at the same time be chargeable, and not chargeable, with knowledge of the same prior art. Assume that an inventor-patentee brings suit for infringement of his patent, that counterclaim is filed for infringement of defendant's patent, and that both parties plead the same prior art. Under the present rule, the plaintiff-inventor would be presumed to have knowledge of all the prior art pleaded against his patent, but under the newly formulated rule he would not be presumed to have had knowledge of any of the same art pleaded by himself.

The Court of Appeals held that the patents in suit were invalidated, each by a different prior patent, because the record did not prove that those prior patents were "generally" or "widely known in the art." The Court said at page 944:

> "As in the case of Hadfield's patent, we should have to be satisfied that the Dutch machine had been widely known in the art;".

Even if the public generally is not chargeable with the same knowledge as is the inventor, there appears to be no good reason why a prior patent, particularly a paper patent, should be promoted to the status of an invalidating patent on the basis of whether or not it was generally or widely known in the art. *The invalidating effect of a prior patent has heretofore depended on its disclosure but under the new rule it would depend on how many people knew about it.*

The new rules set up by the decision in the present case constitute matters of grave concern to the people of this country in connection with the protection of patent rights for inventions provided for by the Constitution and the statutes. These new rules would, if permitted to become the law, presently nullify the patent statutes within the jurisdiction of the Court of Appeals for the Second Circuit and eventually throughout the remainder of the country.

For these reasons, it is respectfully urged that the Petition for Writ of Certiorari be granted.

J. CALVIN BROWN,
Petitioner, Amicus Curiae.

September 20, 1951.

FILED
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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 256

FRANK B. KILLIAN & COMPANY,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

RESPONDENT'S OBJECTION TO THE FILING OF A BRIEF AS AMICUS CURIAE BY J. CALVIN BROWN.

Mr. J. Calvin Brown of Los Angeles, California, has filed a petition for leave to file a brief as *amicus curiae* in support of the petition for a writ of certiorari herein, and appends to his petition the brief he would like to file. Respondent's consent was not asked but would have been refused in any case for the following reasons:

Rule 27, 9 (c) of this Court provides that a motion for leave to file a brief as *amicus curiae* when consent has been refused

> "shall concisely state the nature of the applicant's interest."

Complying, Mr. Brown writes:

> "Petitioner, *amicus curiae,* is National President of The American Society of Mechanical Engineers, and feels that he would be remiss in his duty if he did not file this petition on behalf of the engineering profession generally and their clients",

thus seeking to give the impression that he is the accredited spokesman for the Society and its membership. It is clear, however, from a careful scrutiny of the petition that he has no mandate from the A. S. M. E., and could have none from "the engineering profession generally and their clients". He speaks for no one but himself. Why this gentleman, despite his overweening sense of duty, should be better qualified to instruct the Court than the able lawyers who represent the petitioner, does not appear.

Rule 27, 9 (c) also provides that a motion to file an *amicus* brief without consent shall

> "set forth facts or questions of law that have not been, or reasons for believing that they will not adequately be, presented by the parties".

Mr. Brown's motion (designated a petition) makes no attempt to meet this requirement. The reason is not far to seek. Both points made by Mr. Brown in his proposed brief were adequately presented by the parties and the Court needs no further enlightenment from Mr. Brown.

(1) The Court of Appeals' alleged substitution of an inventor for a mechanic skilled in the art in the standard test of invention.

An argument on this point was presented on pages 18 and 19 of the petition for certiorari and answered on pages 12 and 13 of respondent's brief in opposition.

(2) The holding of the Court of Appeals that the art is not presumed to know of any particular prior patent.

An argument traversing this holding was presented on pages 12-15 of the petition for certiorari and answered on pages 11 and 12 of respondent's brief in opposition.

THE PETITION FOR LEAVE TO FILE A BRIEF AS AMICUS CURIAE SHOULD BE DENIED.

Respectfully,

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Attorneys for Respondent.

September 28, 1951.

AUG 20 1951

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals for the Second Circuit.

BLYTHE D. WATTS,
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Counsel for Petitioner.

GEORGE H. DESSION,
Of Counsel.

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In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. .....

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Youngs Rubber Corporation, prays that a Writ of Certiorari issue to review the judgment entered May 23rd, 1951 (R. 434) of the United States Court of Appeals for the Second Circuit in which petitioner was plaintiff-appellee.

A certified transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in compliance with Rule 38 of the rules of this Court.

OPINIONS OF THE COURTS BELOW.

The Opinion of the United States District Court for the Southern District of New York was filed on July 21, 1950 (R. 399) and is reported at 94 F. Supp. 281.

The Opinion of the United States Court of Appeals for the Second Circuit (R. 416-423) is reported at 188 F. (2d) 945.

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of June 25, 1948 effective Sept. 1, 1948 (28 U. S. C., Section 1254(1)) and under Section 5(b) of Rule 38 of this Court.

The Opinion of the Court of Appeals is dated April 30, 1951 (R. 416). Petition for Rehearing (R. 425) was filed on May 15, 1951, and was denied on May 23, 1951 (R. 434).

QUESTIONS PRESENTED.

(1) Whether Patent No. 2,213,113 is valid and infringed.

(2) Whether Patent No. 2,244,591 is valid.

(3) Whether, despite the uncontroverted finding of the Trial Court that neither the Patent Office nor the defendant cited any prior art to rebut novelty, the Court of Appeals may nevertheless hold a patent invalid for *lack of novelty.*

SUMMARY STATEMENT OF THE MATTER INVOLVED.

Petitioner, Youngs Rubber Corporation, owns Patent No. 2,213,113 (hereinafter called the Visual Test patent), for a Method for Testing Thin Rubber Articles, issued August 27, 1940, and Youngs *et al.* Patent No. 2,244,591 (hereinafter called the Electrical Test patent), for Apparatus for Testing Prophylactic Articles of Thin Rubber, issued June 3, 1941.

This action is brought by petitioner for reversal of the decision of the U. S. Court of Appeals for the Second Circuit that held the patents invalid, and reinstatement of that of the U. S. District Court for the Southern District of New York (Bondy, *J.*) that held both patents valid and infringed.

This case is companion to the case of *Frank B. Killian & Company v. Allied Latex Corporation et al.*, 188 F. (2d) 940 (C. A. 2) in which a Petition for Writ of Certiorari is being filed concurrently herewith.

No questions have been raised as to misuse of patents, unlawful monopoly or other reprehensible conduct that defeats the right to equitable relief in a patent suit.

As appears more fully hereinafter (pp. 4 & 6), years of research proved unavailing in ameliorating the cumbersome and costly prior commercial practice. But, respondent did no research and simply appropriated the teachings of petitioner's patents.

The Visual Test Patent No. 2,213,113 is for a method of testing thin rubber articles, particularly prophylactics, for minute holes therein. According to that method the rubber article is stretched over a rigid cylindrical form, thus completely plugging the article so that neither air nor water could pass from the inside to the outside of a perfect article. Upon dipping the form with the article stretched thereover into and removing it from a bath of water, a clear visual distinction between a good and a bad article is afforded. For, any minute hole in the article allows water to seep and spread promptly into the capillary space between the article and the form over which it was stretched, which is visible through the stretched article as a corresponding dark spot or area that is absent with a good article. The Trial Court made the following Findings of Facts as to this patent:

> "The invention accomplished a new instrumentality for a new test." (R. 401.)
>
> "Air inflation tests (the prior art method) were practiced by plaintiff and others for about 15 years before the advent of the methods disclosed by the two patents in suit." (R. 400.)
>
> "As disclosed by the evidence, the advantages of this visual test over the prior art inflation test were

the reliable, automatic, instant and satisfactory exploration of the entire effective area of the article while in the bath, and even out of the bath, revealing the dark area by the time the article had reached the inspection stage. The chance of error was reduced to a minimum, and the cost of inspection over prior methods and practices was considerably reduced." (R. 401, 2.)

"Plaintiff, the patentee's assignee, promptly utilized the new method in its business, and has continued to do so from 1940 to date with considerable success." (R. 402.)

"Neither the Patent Office nor the defendant has cited any prior patents, publications or public uses anticipating the invention. Though the test may now appear simple, simplicity does not negative invention." (R. 402.)

The Electrical Test Patent No. 2,244,591 is for apparatus employing electrical means to detect holes in the wall of a rubber article, such as a prophylactic, which is stretched over a metallic form* and passed through a conductive bath. The metal form constitutes one electrode, the conductive bath the second electrode and the rubber article on the form is the dielectric of a Temporary Condenser, i.e., a condenser which exists as such for but a few seconds while the article remains dipped in the bath. Briefly stated, the metal form is brought into contact with a charging electrode which applies a voltage to charge the temporary condenser. Then the metal form passes to a testing electrode which is connected through a conventional electrical or electronic circuit to a relay which gives a response depending on whether or not there has been a loss of charge due to leakage from the temporary condenser, caused by a hole in the article.

The Trial Court found to be new the employment of the rubber article as the dielectric of a temporary condenser

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* This form may also be used in the method of the Visual Test patent.

moving in a conductive bath and combined with a conventional electrical circuit for testing the rubber articles. (R. 405.)

The Trial Court also made the following Findings of Fact as to this patent:

> "This invention was promptly put into use, and was and continues to be a valuable and successful contribution to the art; it eliminated the human element, and enabled those articles having holes to be discarded automatically." (R. 406.)

SPECIFICATION OF ERRORS TO BE URGED.

The Court below erred:

(1) In reversing the Trial Court by holding Patent No. 2,213,113 invalid and not infringed.

(2) In reversing the Trial Court by holding Patent No. 2,244,591 invalid.

(3) In holding invalid for lack of novelty the Visual Test patent against which neither the Patent Office nor defendant had cited any prior art.

(4) In holding invalid the Electrical Test patent, though the same involved the radically new instrumentality of the temporary condenser.

(5) In violating Rule 52(a) of the Federal Rules of Civil Procedure by reversing and disregarding Findings of Fact of the Trial Court without any showing that they were clearly erroneous and by failing to make allowance for the advantages possessed by the Trial Court that had observed demonstrations, viewed motion pictures, listened to conflicting testimony and passed on the credibility of witnesses.

REASONS RELIED ON FOR ALLOWANCE OF THE WRIT.

The discretionary power of the Court to grant a Writ of Certiorari is invoked upon the following grounds:

I. The Court Below has Magnified and Distorted This Court's More Recent Decisions in Patent Cases Into a Mandate to Invalidate Every Patent that Comes Before It, Even Such Patents as the One Recently Held Valid by UNANIMOUS DECISION of This Court.

(a) The Court below found as to both patents in suit:

> "It is perhaps interesting that an obvious need was not met sooner in this industry and *certainly in old days that would have told strongly in favor of the patent.*"* (R. 422.)

and as to the Electrical Test patent found:

> "*Undoubtedly this would have been held invention in times past,* but now the climate of opinion has changed to require definite novelty in idea, and not new adaptations of an old idea." (R. 421.)

The Court below correctly found as to the prior commercial practice:

> "* * * that the necessary testing of these articles was by crude devices, including such hand operations as blowing up of each one by an operator and holding it against the face or neck to see if the air was coming out." (R. 422.)

As to this prior art practice, the Trial Court had found:

> "The test accordingly was subject to human error. Moreover, the cost of such testing was extremely high, exceeding the cost of producing the articles. Attempts had been made to perfect an automatic mechanism for air testing in order to reduce the manual labor and high cost of the existing methods, but without satisfactory results. Air inflation tests were practiced by plaintiff

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* Emphasis throughout this Petition is ours unless otherwise noted.

and others for about 15 years before the advent of the methods disclosed by the patents in suit." (R. 400.)

Prior to the invention of the patents in suit there had been more than a decade of unsuccessful effort in the industry to devise a better test than the expensive and unreliable method in general use (R. 12, 22, 63 to 67, 253, 254).*

There is no evidence that the respondent engaged in experimental or developmental work. As the latest comer in the field, respondent simply appropriated petitioner's inventions in full awareness of the patents. Judgment for respondent here would simply encourage appropriation of the useful invention of another, even where, as here, the patentee is not charged with misuse of patents, unlawful monopoly or similar conduct that defeats the right to equitable relief in a patent suit.

In refusing to recognize validity in the face of the history above set forth, the Court below has decided important issues of patent law in manner that conflicts with this Court's pronouncements in *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275, and *Graver Tank and Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271.

In recently passing on a meritorious invention in a technical art, this Court laid down tests in the earlier *Graver v. Linde* case, 336 U. S. 271, which the Court below insists were overruled by this Court's last two patent decisions, viz., *Great Atlantic & Pacific Tea Co. v. Supermarket*, 340 U. S. 147, and *Crest Specialty v. Trager*, ... U. S. ...., 95 L. Ed. 532 (advance sheets). That appears clearly from the following statement in the opinion below:

"Plaintiff urges that the climate of opinion is again shifting, citing the opinions in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 339 U. S. 605.

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* The test used by the Federal Food and Drug Administration served only for samples, since it involved filling the individual prophylactics with water. (R. 36.)

> But that case dealt specifically with the question of equivalents to show infringement, and later decisions do not support the plaintiff's reading of directional signals. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., supra; Crest Specialty v. Trager,* .... U. S. ....." (R. 421.)

Not only has the Court below ignored the earlier *Graver v. Linde* decision (336 U. S. 271) which deals with validity and not merely with infringement, but the reference to "directional signals" shows that the court below believes that this Court has raised the standards of invention even since the later *Graver v. Linde* decision (339 U. S. 605).

The palpable error in the foregoing quotation was pointed out in our Petition for Rehearing below, but that Petition was nevertheless denied without attempt at correction or explanation.

As a matter of fact, the patent involved in said *Great Atlantic & Pacific* case was held invalid because it did not meet the statutory requirements of invention as appears from the following part of the decision:

> "Neither court below has made any finding that old elements which made up this device performed any additional or different function in the combination than they perform out of it." (p. 152.)

But new, radically new and vastly improved results were attained by the inventions of the two patents in suit, as appears from the Findings of Fact of the Trial Court (*supra,* pp. 4 & 6). These are of the tenor of those that prompted this Court's holding of validity in *Graver v. Linde,* 336 U. S. 271.

(b) More specifically, **as to the Visual Test Patent 2,213,113,** the Court reversed the Trial Court by holding invalidity for *lack of novelty,* in the face of the utter absence of prior art cited in the proceedings leading to the grant of the patent, in the Answer to Complaint, and even at the trial. The Court below said:

"We are aware that simplicity alone will not negative invention, Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U. S. 275, 279, but *overwhelming* simplicity must always have its effect in contradicting novelty. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147."

This assertion is tantamount to the proposition that that which is very simple cannot be novel! Apart from the fantastic character of this assertion, it is irreconcilable with the holding of validity in the leading case of *Minerals Separation, et al. v. James M. Hyde,* 242 U. S. 261, where this Court said (at p. 268)

"The simplicity of the operation, as compared with the prior attempts is *startling.*"

As in the *Minerals Separation* case, abstruse laws of surface tension or capillary action were ingeniously harnessed by the inventor to attain a strikingly novel and useful result. This was accomplished by the simple new instrumentality of the Visual Test patent as held by the Trial Court below. Ordinarily capillary action is nothing but a nuisance, as indeed exemplified by the example given by the Court below of gravy on a necktie.

(c) Also more specifically, **as to the Electrical Test Patent 2,242,591,** the Court below overruled the Trial Court's Findings of Fact which were indeed uncontroverted by respondent. The concept of a *temporary condenser* was found to be broadly new. Such temporary condenser is instantly put together for such test. It is made by stretching the rubber article over a metal form which is then dipped into a conductive bath, so that the condenser *exists only during the few seconds* the form remains in the bath. A relay is connected in circuit with that temporary condenser whose response is selective, depending on whether the temporary condenser maintains the electric charge applied thereto (if the article is good), or loses it (if the article is bad).

The Trial Court's Finding of Fact as to this new and valuable principle of the temporary condenser with its unique utility for testing a rubber prophylactic was brushed aside by the Court below in the following words:

> "* * * the patentees took one of the oldest of electric conceptions and adapted it rather ingeniously to a particular need of this business." (R. 421.)

The Court below erroneously concluded that the decision in the case of *Great Atlantic & Pacific v. Supermarket Corp.*, 340 U. S. 147, supersedes and compels disregard of the decision in the recent case of *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271; and that *Graver v. Linde* never was authority for upholding a meritorious patent, despite the fact that this Court upheld the patent there and did so unanimously. Misled by that palpably false interpretation of the expression of this Court, the Court below ignored proof that clearly made out a case of validity on the standards followed in that *Graver v. Linde* case.

II. There is Direct Conflict Between the Decision of the Court Below and Decisions of This Court and of the United States Courts of Appeals for the First, Sixth and Seventh Circuits as to the Interpretation of This Court's Decision in the Case of Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84.

In *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 281, Mr. Justice Black, in his concurring opinion in which he was joined by Mr. Justice Douglas, held that the invention there involved, which resulted from six months of patient trial of some hundreds of flux compositions, shows "patentable discovery when measured by the standards announced by this Court in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84."

The Court below, however, has construed this Court's decision in that *Cuno* case as a mandate indiscriminately to invalidate patents and has never even attempted to dis-

tinguish that case as did at considerable length the Courts of Appeals for the First, Sixth and Seventh Circuits in upholding patents far less impressive in history and attainments than those in the case here involved.

We draw particular attention to:

Trabon Engineering Corporation v. Dirkes, 136 F. (2d) 24 (C. A. 6);

Brown & Sharpe Mfg. Co., et al. v. Kar Engineering Co., Inc., 154 F. (2d) 48 (C. A. 1) (certiorari denied, 328 U. S. 869, Petition for Rehearing denied, 329 U. S. 822);

Falkenberg v. Bernard Edward Co., 175 F. (2d) 427 (C. A. 7) (certiorari denied, 338 U. S. 870).

III. The Court Below Has So Far Departed From the Accepted and Usual Course of Judicial Proceedings As to Call For an Exercise of This Court's Power of Supervision.

Such departure consisted in violation of Rule 52(a) of the Federal Rules of Civil Procedure by setting aside Findings of Fact made by the Trial Court and that are not clearly erroneous. More particularly:

(a) The Trial Court found as to the device which comprises a form and the rubber sheath stretched thereover and which is to be immersed in the bath in order to perform the Visual Test:

> "The invention accomplished a new instrumentality for a new test." (R. 401.)

Disregarding such Finding of Fact, the Court below says:

> "The defendant is on solid ground in urging that mere observation of a natural process can hardly be considered to possess such novelty. Otherwise one might expect the observable results of water on silks or satins or gravy on a necktie to appear as patents."

To spill water upon a rubber prophylactic sheath would not render visible a minute hole therein, since rubber, unlike a necktie, is impervious to water. The dark area appears *only* if the water passing through a hole in the sheath is made to spread under the sheath along the minute capillary space between the sheath and the form over which the sheath has been stretched prior to immersion in the bath. That is the *new instrumentality* found by the Trial Court and without which the tell-tale dark area could not possibly make its appearance as a "natural process" or otherwise. It is this *new instrumentality* that alone can call forth the manifestation of what the Court below calls a "natural process."

(b) The Trial Court found as to the Visual Test patent:

> "While the visual method might not be part of defendant's regular testing routine, it is *readily capable of being used* by employing the services of an inspector." (R. 404.)

In direct contradiction of this Finding, the Court below says:

> "* * * in defendant's machine * * * the forms after their immersion were in a place where one would hardly think of examining them and *could not do so conveniently.*" (R. 419.)

(c) The Trial Court further found as to the Visual Test patent:

> "* * * for example, frequent opportunities to observe the spots arise in connection with *checking the electrical apparatus to assure that it is in proper working order for testing purposes.*" (R. 404.)

In direct contradiction of this Finding, the Court below says:

> "* * * in defendant's machine the possibility of inspection came *only after* the electrical test had operated."

The Court below does not indicate that the foregoing Findings of Fact made by the Trial Court are clearly erroneous. Manifestly they are not for they find ample support in the record (R. 103, 177, 178, 186, 187, 250).

Indeed, the Court below concedes:

> "Perhaps we should hesitate to upset the finding of fact of a trial judge on an issue of this kind," (R. 419)

but, as we have seen, it has nevertheless upset them, despite its expressed misgivings.

(d) The Trial Court found as to the Electrical Test patent:

> "* * * the metal form is one electrode, the conductive bath a second electrode, and the rubber article the insulation or dielectric of a *temporary condenser*—a condenser that exists as such for but a few seconds while the article remains dipped in the bath through which it passes for the Visual Test." (R. 405.)
>
> * * * * *
>
> "Defendant's apparatus uses substantially similar metal forms, stretches the rubber article thereover, conveys same through a conductive bath containing aerosol, forming a *temporary condenser* exactly as taught in the claims. It connects the metal form and bath to an electrical circuit for charging and discharging the *temporary condenser* depending on whether the article has a hole, that is, on whether or not there is leakage, and provides a relay responsive to the electrical circuit for testing a good article rather than a bad one." (R. 407.)

Not only are these Findings substantiated in the record (R. 151 to 154), and therefore not clearly erroneous, but their correctness is indeed conceded by respondent's expert (R. pp. 216, 219, 220, 227) who admits that this application of the rubber sheath so that it constitutes the dielectric of a *temporary condenser* for test purposes is *new* and is both *disclosed* in the patent and *used* by defendant.

The Court below, however, completely disregards all the Findings and admissions as to the *temporary condenser* and holds that:

> "* * * the patentees took one of the oldest of electrical conceptions and adapted it rather ingeniously to a particular need of this business."

(e) The Trial Court found as to the prior art bearing on the Electrical Test patent:

> "The Electrical World article of March 12, 1927, disclosed the testing of thick rubber gloves by filling them with water, immersing the gloves in a tank of water, and then applying a high voltage alternating current through the thickness of the glove and discarding those gloves that did not withstand the applied voltage; the high alternating current was *to break through a bad glove* and *could not be used* for charging a temporary condenser; there was *no condenser, no charging action, no leakage,* and *no metal form* within the rubber article to act as one of the electrodes of a temporary condenser." (R. 406.)

The Court below, however, disregards these Findings of Fact as to the "Electrical World" article and says:

> "Here, then, was a device in use for testing rubber goods by using electrical current conducted through water; we see no substantial difference between the water as the conductor on both sides of the article as in this device and the water and metal of the patent under consideration here. The fact that one was a high-voltage test for imperfections, rather than holes, in the glove, while the other was one of low voltage for holes, seems a difference in degree, and not of kind."

The setting aside of a vital Finding of Fact occurred in the face of the admission of respondent's expert that the alternating current used in the "Electrical World" article would have *no utility* for the purpose of the patent in suit (R. 217) and there is *no condenser charging action* (R. 218).

In setting aside the Findings of Fact of the Trial Court, the Court below disregarded the following clear admonition of this Court:—

> "These findings are to the effect that the new combinations, while they involve old mechanical constructions, combine these in a new way so as to produce an improved result. These are Findings of Fact, despite the petitioner's apparent contention to the contrary, and we will not disturb such concurrent findings, where as here, there is evidence to support them." *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367.

CONCLUSION AND PRAYER.

A vital issue is presented by this petition. Does the Court of Appeals for the Second Circuit correctly apply the standards of invention set by this Court? We maintain it does not and unless corrected, patents will become a nullity in the Second Circuit.

WHEREFORE, your petitioner respectfully prays that a Writ of Certiorari be issued to the Circuit Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals for the Second Circuit be reversed, and that petitioner be granted such other and further relief as may be proper.

Respectfully submitted,

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Counsel for Petitioner.

GEORGE H. DESSION,
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August 17, 1951.

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Office-Supreme Court, U. S.
SEP 20
CHARLES ELMORE CROPLEY

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 257

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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SUPPLEMENTARY STATEMENT.

OF THE TWO PATENTS involved in this suit, the first, Youngs, No. 2,213,113, August 27, 1940, the "Visual Test Patent," was held invalid for lack of novelty (R. 419), and the second, Youngs and Ballantine, No. 2,244,591, June 3, 1941, the "Electrical Test Patent", was held invalid for anticipation (R. 422).

Petitioner charges (Pet. 3) that "respondent did no research and simply appropriated the teachings of petitioner's patents". But whether respondent did any research or not—actually it did plenty—is beside the point; respondent is not charged with appropriating trade-secrets or with any other form of unfair competition. As for appropriating the teachings of petitioner's patent, that depends upon whether those patents disclose and claim any novel contributions to the art subject to appropriation, and the charge, therefore, begs the question.

This is the first and only time these patents have been litigated so that the case presents no question of conflict as to either validity or infringement. Nor does it present any other question requiring this Court's answer.

SUMMARY OF ARGUMENT.

The first patent in suit, the Visual Test Patent, purports to cover a method of testing thin rubber articles for holes, but the method as claimed consists only of snugly mounting an article to be tested on a form and immersing it in water, whereupon the water, entering any sizeable hole, forms a visible dark spot around it. Although Youngs, observing this old natural phenomenon, may have understood its significance, the Court of Appeals held that the mere observation of a natural process lacked patentable

novelty. At the trial, petitioner's expert conceded that it had been known for at least 40 years to test rubber articles, such as rubber gloves, by means of an electrical test in which the rubber article was located between metal and water, exactly as disclosed in the Visual Test Patent. The formation of dark spots was inevitable. The Court of Appeals held that seeing the inevitable was not patentable, and that the Visual Test Patent could not be used to prevent the art from using the old electrical test.

The second patent in suit, the Electrical Test Patent, discloses and claims apparatus for testing thin rubber articles for holes by means of electric current leakage. A test article is stretched upon a metal form, immersed in a bath of water or other conductive liquid, exactly as in the visual test, and an attempt made to pass an electric current from the form to the bath through the rubber article. If the article is sound no current will flow because rubber is an insulator; if the article has a hole, contact is made between the form and the bath and electric leakage current flows, indicating by suitable means the presence of the hole. But such apparatus was not new, as the record showed, and the Court of Appeals held the claims in suit invalid for anticipation.

The Court of Appeals, disposing of one patent for lack of novelty and the other for anticipation had no need to apply the exacting standard of invention, the importance of which this Court has latterly reiterated.

In reversing the District Court the Court of Appeals relied upon undisputed evidence and so did not violate the provisions of Rule 52 (a) F.R.C.P.

Neither patent in suit had been previously adjudicated so there is no conflict. Nor does the case present any other question requiring this Court's attention.

ARGUMENT.

THE VISUAL TEST PATENT. YOUNGS, NO. 2,213,113 (R. 228).

This patent relates to a method of visually detecting the presence of holes in thin rubber articles. The patentee says:

> "The present invention is based essentially upon the discovery that by stretching prophylactic articles of thin rubber over a mandrel or other supporting form and then immersing the same in a bath of liquid, the said liquid will pass through even the most minute hole or perforation in the article and spread over the interior surface thereof between said article and mandrel producing a comparatively dark spot or area which is readily perceptible to the human eye" (p. 1, col. 1, lines 40-49).

This describes a natural phenomenon "which is readily perceptible to the human eye". Youngs, of course, did not invent the phenomenon; he simply observed and understood it. The phenomenon, manifesting itself in accordance with natural laws, manifests itself whenever conditions are propitious whether or not a perceptive human eye be within eyeshot. Petitioner's expert conceded that a prophylactic on a metal form is a sheet of insulating material and that it had been known for more than 40 years to test for holes in insulating material by interposing such material between the metal and the water, and attempting to pass an electric current between the metal and the water through any holes in the insulation (R. 112-113). Petitioner's expert further admitted that prior to 1937 (the patent was filed October 10, 1939) rubber gloves had been tested by mounting them snugly on metal forms, dipping them into water, attempting to pass an electric current through the gloves, and measuring any

current passed (R. 137, 139, 154). Conditions being propitious for the dark spot phenomenon it must surely have manifested itself during those old tests. So it comes to this: was Youngs entitled to a patent for observing this phenomenon? The Court of Appeals thought not—and properly so.

Conceivably Youngs might have utilized the dark spot phenomenon in some patentable way. Conceivably the machine which he devised for this purpose might have had patentable features, but if so he did not claim them. He claimed merely the method of producing the inevitable dark spot: mounting the test article on a form and dunking it. But this, without more, was not new. As for mere observation of a natural phenomenon, the Court of Appeals said (R. 418):

> "a method patent in general must ultimately come back to some law of nature or natural phenomenon; many a patent must rely on and make use of the law of gravity, the law of friction, the law of conservation of energy. But in general these will be found embodied in some process of a new or novel nature leading to the planned end. The defendant is on solid ground in urging that mere observation of a natural process can hardly be considered to possess such novelty."

Whereupon the Court held the patent invalid "for lack of novelty" (R. 419).

THE ELECTRICAL TEST PATENT.

YOUNGS AND BALLANTINE, NO. 2,244,591 (R. 232).

The nature of the invention of this patent is stated in the opening sentence of the specification.

> "This invention relates to new and useful improvements in apparatus for testing thin rubber articles and more particularly for testing such articles for imperfections, such as holes and perforations therein."

The presence of holes is indicated electrically rather than visually as in the Visual Test Patent. Thus, beginning on line 69, column 2, page 2 of the patent, the patentees state:

> "This detection of imperfections in the articles through the medium of an electric current involves the principle of current leakage through the rubber article."

The electrical test of this patent is fundamentally a very simple one. The rubber article to be tested is mounted on a metal form or mandrel, which stretches it slightly to eliminate wrinkles, as in the visual test, and immersed in a tank containing an electrically conductive bath which is connected in series with an indicator, such as an electric lamp, a source of current, and a test electrode. As a preliminary step the form engages a grounded electrode (unclaimed) to discharge any static charge which may be accidentally present. It is subsequently brought into contact with the test electrode. If the article is without holes no current will flow, because the rubber acts as an insulator, and the lamp will not light; but if there *is* a hole the liquid of the bath will flow through it and make contact with the form, whereupon a leakage current will flow, the lamp will light, thus indicating that an imperfect article is on test, and a removal device (unclaimed) may be readied for action. In practice, however, when low voltage test currents are used for safety's sake, the current flowing through a small hole in an imperfect article is too small to light a lamp, or swing the needle of a milliammeter, or trigger a removal apparatus, and so it must be amplified. But there was nothing new in amplification or in the amplifying means used by the patentee, as plaintiff's expert conceded (R. 113, 123, 137).

Neither was Youngs and Ballantine's leakage current test for detecting the presence of holes in rubber articles new, as petitioner's expert admitted. Furthermore, it had

been described, applied to rubber gloves, in an article published in the Electrical World for March 12, 1927 (R. 278). Discussing this article the Court of Appeals wrote (R. 422):

> "The device there pictured and described showed a grounded tank of water from which a lead was taken through a power source to an indicator. From the other side of the indicator was a lead to a horizontal metal rod to which were attached metal chains allowed to hang vertically. The lower ends of these chains were dropped into the upper and open ends of the gloves, which were themselves filled with water. When the voltage was raised to the required test level, current would flow through the indicator if the article was unsound, but not otherwise. Here, then, was a device in use for testing rubber goods by using electrical current conducted through water; we see no substantial difference between the water as the conductor on both sides of the article as in this device and the water and metal of the patent under consideration here. The fact that one was a high-voltage test for imperfections, rather than holes, in the glove, while the other was one of low voltage for holes, seems a difference in degree, and not of kind. We think therefore that the 'Electrical World' article must be considered a printed anticipation of the plaintiff's device, . . ."

This ought to put an end to the matter; but before leaving this patent we must consider briefly the theory of the temporary condenser by which petitioner sets such store. Petitioner, describing the electrical test, writes (Pet. 4):

> "The metal form constitutes one electrode, the conductive bath the second electrode and the rubber article on the form is the dielectric of a Temporary Condenser, i. e., a condenser which exists as such for

but a few seconds while the article remains dipped in the bath. Briefly stated, the metal form is brought into contact with a charging electrode which applies a voltage to charge the temporary condenser. Then the metal form passes to a testing electrode which is connected through a conventional electrical or electronic circuit to a relay which gives a response depending on whether or not there has been a loss of charge due to leakage from the temporary condenser, caused by a hole in the article."

And again (Pet. 9):

"The concept of a *temporary condenser* was found to be broadly new. Such temporary condenser is instantly put together for such test. It is made by stretching the rubber article over a metal form which is then dipped into a conductive bath, so that the condenser *exists only during the few seconds* the form remains in the bath. A relay is connected in circuit with that temporary condenser whose response is selective, depending on whether the temporary condenser maintains the electric charge applied thereto (if the article is good), or loses it (if the article is bad)."

Or as petitioner wrote in its brief below:

"The concept of incorporating the prophylactic rubber article as the dielectric of a *temporary* condenser in the testing machine . . . is the very *heart* or *capital idea* of the invention."

There are several flaws in this argument, not the least of which is that it finds no support in the patent. Each of the four claims in suit, Nos. 1, 5, 21 and 25, defines a simple leakage test apparatus and makes no reference to condensers or dielectrics, temporary or otherwise. Now it is

unfortunately true that a sound article, mounted on its form, *does* act as the dielectric of a temporary condenser so that when a form carrying such an article engages the test electrode, current will surge in to charge the condenser and thus give a false signal unless something is done to prevent it. Youngs and Ballantine prevent it by precharging the condenser at a charging electrode so that when the sound article arrives at the test electrode no further charge can surge in and give a false signal. So "the very *heart* or *capital idea* of the invention" turns out to be, ironically, a nuisance to be abated! Furthermore, there is no claim to the precharging step or the apparatus for performing it. The Court of Appeals correctly appraised the situation (R. 420):

> "It will be noted that contact with the first two electrodes [the static discharge electrode and the charging electrode] is essentially a conditioning process to prevent a 'surge' of potential or a false charge which might momentarily disturb the delicate indicator and thus temporarily mislead the operator or even 'trigger' the removal device if that is in use. Contact with the third or 'test' electrode is the important step; that embodies the inventive idea claimed in the patent and in the claims 1, 5, 21 and 25 here in issue. These, after describing the 'electrically conductive element,' i. e., the mandrel, and the 'trough' for immersion of the rubber article stretched on the mandrel, proceed to state the essential invention in language such as this of claim 1: 'electrical means connected to the element and said trough and *operable in response to the presence of a hole in the article,* and means operable by said electrical means for indicating the presence of a hole in said article" (the Court's italics).

Petitioner does not challenge this appraisal. In short, the claims cover a simple current leakage test apparatus, the

essentials of which had been disclosed in the Electrical World article, and were conceded to be old.

It may be noted parenthetically at this point, that any one performing the electrical test of this second patent, which the Court of Appeals found anticipated by the prior art and hence in the public domain, must willy-nilly infringe the claims of the first or Visual Test Patent unless, as the Court suggested (R. 419), one "put on blinders to avoid observation", a *reductio ad absurdum* which in the opinion of the Court, "illustrates the lack of worth of the patent"—the Visual Test Patent.

OTHER DEFENSES.

Not only are the claims in suit invalid for lack of novelty and anticipation, as the Court of Appeals found; it is our position that when properly construed they are not infringed. Furthermore, the claims of the Visual Test Patent are invalid because not directed to a statutory method and, having been granted to Youngs as a sole inventor, are invalid over the previously filed Electrical Test Patent granted to Youngs *and* Ballantine as joint inventors.

THE REASONS RELIED ON BY PETITIONER FOR ALLOWANCE OF THE WRIT.

Of the three reasons stated, the first two (Pet. 6 and 10) have to do with the too exacting standard of invention which, so petitioner avers, the Court below applied, thereby misinterpreting recent decisions of this Court on the point. It seems to us that petitioner has misread the opinion below. The claims in suit were *not* held invalid for lack of invention, whatever views on the quality of invention displayed the Court may have entertained; the Visual Test Patent was held invalid "for lack of novelty", and the Electrical Test Patent for "anticipation".

A patent may disclose and claim a novel thing and yet lack invention, or it may display the quality of original invention and yet, unhappily, lack novelty. In either case the patent is invalid, but for different reasons. The statute, R. S. 4886, prescribes the three imperatives of patentability: invention, novelty, utility, lacking any of which a patent must fall. Here we are concerned with lack of novelty.

As for the third reason (Pet. 11): that the Court of Appeals violated Rule 52 (a) F.R.C.P. by setting aside findings of fact made by the Trial Court that were not clearly erroneous, it is plain from what we have just said that the Appellate Court's findings as to novelty and anticipation were based on undisputed evidence which that Court could appraise as well as the Trial Court, and that in the opinion of the Appellate Court the findings of the Trial Court, based on this evidence, *were*, "clearly erroneous". We respectfully call this Court's attention to the section on Rule 52 (a) in our brief in *Frank B. Killian & Co.* v. *Allied Latex Corp.*, No. 256, filed concurrently herewith.

THERE IS NO GOOD REASON WHY THE WRIT SHOULD BE ALLOWED.

Petitioner concludes (Pet. 15) with a rhetorical question: "Does the Court of Appeals for the Second Circuit correctly apply the standards of invention set by this Court?", and then proceeds to answer it: "We maintain it does not and unless corrected, patents will become a nullity in the Second Circuit". But this horrendous improbability need not concern us here, because the Court of Appeals for the Second Circuit did *not* hold the patents in suit invalid for lack of invention, but for lack of novelty and for anticipation and, therefore, had no need to apply, either correctly *or* incorrectly, the standards of invention set by this Court.

Like the companion Killian case, this is just another patent suit in which the defeated litigant turns to this Court in the hope of obtaining a favorable decision. As the two patents in suit had never been adjudicated before there is no conflict, and the case presents no questions requiring answer by this Court.

THE PETITION FOR A WRIT OF CERTIORARI SHOULD BE DENIED.

Respectfully,

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In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

PETITIONER'S REPLY BRIEF.

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October 4, 1951.

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In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,

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Respondent.

PETITIONER'S REPLY BRIEF.

Respondent's brief does not meet any of the three Grounds relied on for allowance of the Writ.

Respondent does not allege any disagreement with Ground I which reads as follows:

> "The Court Below has Magnified and Distorted This Court's More Recent Decisions in Patent Cases Into a Mandate to Invalidate Every Patent that Comes Before It, Even Such Patents as the One Recently Held Valid by *Unanimous Decision* of This Court."

Respondent offers as its excuse for evading this issue, that the Court below had found the patents invalid for "lack of novelty" and for "anticipation," respectively (pp. 1, 9), and therefore "had no need to apply the exacting standard of invention, the importance of which this Court has latterly reiterated." (p. 2.) We shall show hereinafter that respondent has misinterpreted the clear language of the decision below which has *not* held the patents invalid on any such grounds, but to the contrary has misapplied the standards of invention as set forth in Ground I.

Respondent's brief does not even pretend to meet, and for that matter does not even comment on, Ground II which reads as follows:

> "There is Direct Conflict Between the Decision of the Court Below and Decisions of This Court and of the United States Courts of Appeals for the First, Sixth and Seventh Circuits as to Interpretation of This Court's Decision in the Case of Cuno Engineering Corp. v. Automatic Devices Corp., 314 U. S. 84."

The inference is inescapable that respondent agrees the Petition should be granted as to Ground II.

As to Ground III the Petition quotes in detail for ready comparison no less than *five* material and controlling Findings of Fact of the Trial Court which are paired with the contrary Findings of the Court below (Pet. 11-14). In each of these instances the Court below had thus upset Findings of Fact of the Trial Court without showing that they are clearly erroneous. In fact, the Court below frankly admitted that it had upset the Trial Court's Findings of Fact (Pet. 13). Respondent's brief makes the bald and unsupported assertion that what the Court below decided was "based on undisputed evidence" (p. 10) but does not even attempt to point out error in any of these five instances of violation of Rule 52(a) F. R. C. P.

In its attempt to dissuade this Court from granting the Petition, respondent was constrained to concede that each of the two patents in suit shows both invention and utility (p. 10). The record warrants that concession, for neither invention nor utility could be seriously contested in the face of the uncontroverted history of the inventions set forth in the Petition (p. 10).

"Here we are concerned with lack of novelty" says respondent (p. 10). Respondent further says "The Court

of Appeals for the Second Circuit did *not** hold the patents in suit invalid for lack of invention, but for lack of novelty and for anticipation" (p. 10).

The Court below did not so hold.

It held the Visual Test patent No. 2,213,113 invalid for "overwhelming simplicity." On the record a finding of "lack of novelty" was impossible, for no prior art had been adduced against this patent for any purpose. As to the Electrical Test Patent No. 2,244,591, the Court below far from finding "anticipation," *conceded* that "undoubtedly this would have been held invention in times past."

The Court below justifies its holding under the impression that "now the climate of opinion has changed" (R. 421). Respondent (Br. 2, 10), like petitioner (Pet. 7-11), disagrees with the Court below as to any change in the climate of opinion or standard of invention set by this Court. This Court has merely stressed that the exacting standards of invention which it has always prescribed should not be relaxed.

We shall now more fully reply and shall point out the errors of fact in respondent's brief, first with respect to the Visual Test patent and then with respect to the Electrical Test patent.

The Visual Test Patent No. 2,213,113.

Respondent asserts that:

(a) Youngs did nothing more than simply to observe and understand a natural phenomenon which is readily perceptible to the human eye (pp. 1, 2, 3, 4), and

(b) petitioner's expert conceded that rubber gloves had been tested for at least forty years in

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* Emphasis is respondent's.

manner in which the appearance of the dark areas was inevitable (pp. 2, 3).

Were these assertions established by the record, the highly experienced Judge William Bondy would not have held the patent valid as he did. Both assertions are utterly erroneous and without basis in the record as will now appear.

(a) As to the Visual Test, the Court below correctly held:—

> "The defendant objects that this is but a patent upon a law of nature or a natural phenomenon. Objection thus expressed is too broad, since a method patent in general must ultimately come back to some law of nature or natural phenomenon; * * *" (R. 418).

Thus the Court below, contrary to respondent (pp. 1 to 4) expressly refused to hold that Youngs had merely observed a law of nature. The Court held the patent invalid solely on the astounding and unprecedented presumption that while "* * * simplicity alone will not negative invention, *Goodyear Tire & Rubber Co. v. Ray-O-Vac,* 321 U. S. 275, 279," "* * * *overwhelming** simplicity must always have its effect in contradicting novelty." (R. 418, 9.) That assertion is contrary to the principle announced by this Court in *Minerals Separation, et al., v. James Hyde,* 242 U. S. 261. That principle was re-stated by this Court as recently as 1944 in the following words:

> "Retrospective simplicity is often a misleading test of invention where it appears that the patentee's conception in fact solved a recognized problem that had baffled the contemporary art * * *" *Universal Oil Products Co. v. Globe Oil & Refining Co.,* 322 U. S. 471, 486.

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* Emphasis ours unless otherwise noted.

That the contemporary art had been baffled in the instant case, is undenied, for respondent took no issue with the following statement:

> "Prior to the invention of the patents in suit there had been more than a decade of unsuccessful effort in the industry to devise a better test than the expensive and unreliable method in general use" (R. 12, 22, 63 to 67, 253, 254). (Pet. 7.)

Contrary to respondent's assertion, there is not an iota of evidence in the record that anyone prior to Youngs had ever tested *thin rubber articles* in *stretched* condition over a form by dipping. Indeed there is no evidence that thin rubber articles had ever been stretched over a form for test purposes, in any mode of test whether by dipping or otherwise.

The thin rubber article thus stretched is what the Trial Court found to be a new instrumentality (Pet. 3). That *new* instrumentality *alone* evokes the dark area "readily perceptible to the human eye" and this is due to the spread of water under the stretched rubber sheath, since the dark area becomes visible against the background of the supporting form by reason of the *translucency* of the thin rubber sheath thereover when thus stretched.

Even claim 1 of the Visual Test patent, which the Court below quotes (R. 418) and calls "very broad" includes the particular limitation to the *thin* rubber articles mounted upon a body in *a comparatively stretched condition* and moreover recites the precise mode of passage of the liquid through any hole in the article over the underlying supporting surface of the body with the comparatively dark area readily visible through the article.

Regardless whether the Visual Test is used as such or in the environment of the Electrical Test patent, it reliably, indeed inevitably, shows the dark area about a hole in the

thin rubber article under test. Whether the electrical impulse used in the Electrical Test is or is not applied, the Visual Test functions at all times. It does so, because the Electrical Test patent like the Visual Test patent uses the *new instrumentality* of the thin rubber article stretched over a metal form and dipped into a bath.

The Visual Test is thus a standby system, at all times operative, should the fully automatic system of the Electrical Test patent ever fail. By what process of logic respondent spells lack of worth (p. 9) out of this virtue of the Visual Test is indeed baffling.

(b) That petitioner's expert had admitted it was old to test rubber gloves on metal forms dipped in water as alleged (pp. 2, 3) is contrary to the fact. Petitioner's expert testified that he had no recollection of seeing such a reference or system (R. 138). Nor has *respondent's* expert any such recollection (R. 224). And respondent's attorney admits there is no reference to such practice in the literature (R. 137). Nor did respondent ever act on petitioner's invitation to stipulate into evidence the admission of such reference whenever respondent could produce it. (R. 224.)

Since no prior art was adduced by the Patent Office, nor by respondent, nor mentioned by the Court below in support of its holding of invalidity of the Visual Test patent, that holding being based solely on "*overwhelming* simplicity," respondent is indeed hard pressed to find a basis for arguing lack of *novelty*.

And therefore the alleged admission of petitioner's expert is here *for the first time* being urged against the Visual Test patent. It is being so urged not only without basis in the record as we shall show, but without basis in anything said by either of the Courts below and without mention by respondent in any brief or argument below.

But that alleged admission on which respondent leans so heavily, even if taken at its face value does not support respondent's argument. For petitioner's expert referred to the testing of *insulating materials* only (R. 112-3), these being materials used in the electrical arts. Insulating material (vulcanite, bakelite, etc.) is neither thin nor stretched, nor even stretchable, and when such material is interposed between metal and water, no dark area could be visible to the eye, for the simple reason that such material is thick and *not translucent*. Should any water pass through a hole therein, and spread thereunder it would not and could not be visible through the thick, unstretched and unstretchable opaque material. Accordingly, in such test there was no natural phenomenon of the dark area "readily perceptible to the human eye" or perceptible at all.

With the numerous workers in the electrical testing arts, it is incredible that in more than forty years of such test, no one had ever been sufficiently observant to see the dark area, if it be the fact that such test had ever been made with materials and instrumentalities that would give rise to the dark area. The art would not have made shift for fifteen years with the awkward, expensive and unreliable air inflation test were the physical phenomenon on which the patent is based ever possible of observation in the countless tests of insulating material made during the past forty years. The art would not have made its persistent and unsuccessful efforts for more than a decade to improve on the objectionable air inflation test that alone was available prior to Youngs' invention, were the phenomenon cited by respondent "readily perceptible to the human eye." Some passing reference at least would have been found somewhere in the technical, if not in the patent literature, had it ever been possible to observe this phenomenon before Youngs created the new instrumentality

that for the first time furnished the necessary setting to call forth the appearance of the dark area. The Patent Office, or respondent's counsel, would have found such published material to cite against the patent, were the phenomenon in question ever available for observation.

The only citation concerned with testing rubber, in this case heavy electrical linemen's gloves, is the Electrical World article to which respondent refers (p. 6). The rubber here is thick, it is not stretched, it is not mounted on a form, but is filled with and immersed in water. And not even respondent argues that the dark area would appear in use of the teaching of that citation; nor does the Court below so hold.

Respondent significantly admits (p. 2) that the appearance of the dark area at a hole is *inevitable* when the new instrumentality of Youngs is used. Anything so *inevitable* would of necessity have been observed in the myriads of tests of insulating material during the last forty years, were such tests made under conditions in which the dark area could possibly have made its appearance. That which became *inevitable* once Youngs made his invention, did not occur even once in the countless millions of electrical tests made in more than forty years before Youngs' invention.

The Electrical Test Patent No. 2,244,091.

Respondent says (pp. 1, 10) that this patent was held invalid for anticipation.

Quite to the contrary, the Court below held as to the Electrical Test patent:

> "Undoubtedly this would have been held invention in times past, but now the climate of opinion has changed to require definite novelty in idea and not merely new adaptations of an old idea." (R. 428)

The Court further said:

> "It will thus be seen that the patentees took one of the oldest of electrical conceptions and adapted it rather ingeniously to a particular need of this business." (R. 428)

Contrary to respondent's assertion, the Court below had found the patent invalid solely for lack of invention. It did so by applying standards, contrary to the Patent Statute (35 U. S. C. 31; R. S. 4886) which sanction a patent, not merely for a new art, but for "any new and useful *improvements* thereof." Respondent admittedly is side-stepping the basic issue of whether the Court below had correctly applied the standards of invention set by this Court (pp. 9, 10).

Not only as we have seen, does the Electrical Test patent use as an element the same new instrumentality of the Visual Test patent, namely, the thin rubber article stretched over a form, in this case a metal form, but it uses that instrumentality in manner to function as a *temporary condenser* in carrying out the Electrical Test.

In applying the Electrical Test, petitioner electrically charges this temporary electrical condenser. As stated by petitioner's expert without contradiction, "* * * if you do not charge it, it is just static and there is nothing accomplished, and it is not utilized as a condenser" (R. 152). The condenser maintains its charge if the article is good, and loses its charge if the article is bad, which affords the discrimination between a good and a bad article. Respondent is merely indulging in rhetoric in its argument on page 8.

Respondent makes no attempt to explain away the admissions of *respondent's* expert (R. 216, 219, 220, 227) that the temporary condenser is new and is both disclosed in the patent and used by respondent. Furthermore

throughout its brief before the Court below, respondent (consistently with the admissions of respondent's expert), eloquently admits that respondent's system in fact uses the temporary condenser. We will quote a few of these admissions.

> "* * * defendant * * * *does* utilize the capacity of that temporary condenser as the very heart or capital idea of *its* system"! (Brief below, p. 20.)
>
> "In short, defendant's machine positively selects the good article because the temporary condenser of which the good article acts as the dielectric carries a charge which actuates the selecting mechanism." (Brief below, p. 21.)

And, referring to the article being tested

> "* * * in defendant's system it is the dielectric of a temporary condenser." (Brief below, p. 25.)

Respondent did not gratuitously make this thrice repeated admission below, but argued that the temporary condenser though present and admittedly present in respondent's system, is absent from the patent in suit, as is also alleged here (pp. 7, 8). The groundlessness of that contention appears from the face of the specification of the Electrical Test patent:

> "* * * the rubber article which, being a dielectric and disposed between the metal mandrel body 14 and the liquid bath, functions therewith as *a condenser*" (R. 236, col. 2, lines 72 to 75),

and again

> "As previously stated the rubber article in effect constitutes the dielectric of *a condenser* formed thereby in conjunction with the mandrel body 14 and the liquid bath * * *." (R. 238, col. 1, lines 68 to 71.)

In the face of all this undisputed evidence, respondent oversimplifies the issue in its summary description of the

Electrical Test patent in which it makes no reference to the temporary condenser (p. 2).

Respondent does not deny that the essential elements that make up the temporary condenser and its use as such are inherent in the recital in each of the four claims in suit.

The Court below made short shrift of respondent's attempt to show that its admitted use of the temporary condenser can escape infringement of the patent. It said:

> "* * * we should have no difficulty in finding infringement. The defendant's device appears to follow so directly the plaintiff's idea, with only the merest reversal of positions—and of circuits—in the form of testing, as if consciously in search of a formal opposite to plaintiff's method. * * * and all of defendant's semantic difficulties with various labels, such as dielectric, condenser, resistor, or the like, do not change this fact. Defendant is here caught with the kind of proposition which in opposite terms it would apply to the plaintiff; * * * Such word chopping cannot conceal the fact that the test demonstrates to the operator the existence or nonexistence of a hole by means of the electrical circuit." (R. 423)

Respondent (p. 12) discusses the Electrical World article of March 12, 1927, but does not comment on the setting aside by the Court below of significant Findings of Fact by the Trial Court (Pet. 14). The systems of the Electrical World article use "a high voltage to puncture the dielectric, if possible, and thereby determine if the article is good or bad. They do not utilize or have not utilized the charge on the condenser for operation of an indicator" (R. 152). Neither the Court below, nor even respondent asserts that the action of the temporary condenser occurs or can occur with the *alternating current high tension* current used in this citation and in the absence of a form. And *respondent's* expert admits that there is no condenser action here (R. 217-8).

The temporary condenser having been admitted by respondent's expert to be fundamentally new in the Electrical Test patent and to be used by respondent and the Court below having found infringement by respondent, the Court below should have affirmed the Trial Court's holding not only as to infringement but as to validity as well.

Indeed, by disregarding the clean-cut admission as to the temporary condenser by respondent's highly qualified expert, and by disregarding the equally clean-cut finding of the Trial Court as to the temporary condenser in the Electrical Test patent (R. 405), the absence of such temporary condenser in any of the prior art (R. 406) and the presence of such temporary condenser in respondent's system (R. 407) the Court below clearly violated Rule 52a F. R. C. P. Respondent baldly asserts (pp. 2, 10) that the Court below had *relied* upon undisputed evidence. To the contrary, the Court below *disregarded* undisputed evidence. In fact as we have shown, the Court below goes so far as to admit that it had upset Findings of Fact of the Trial Court (Pet. 13).

Respondent does not contradict or even comment in its general discussion (p. 10) of said Rule 52(a) on any of the various specific instances quoted in the Petition in which the Court below has set aside Findings of Fact made by the Trial Court after observing demonstrations, viewing motion pictures, listening to conflicting testimony and passing on the credibility of witnesses (Pet. 11 to 15).

Respondent's brief does not discuss or even cite a single authority to support its argument. Nor does it take exception to our discussion of the more recent decisions of this Court (Pet. 7, 8, 9, 10). In sedulously avoiding such discussion, respondent evidently shares the generally prevailing conviction that the Court below is out of line in the standard of invention that it sets.

Two United States Courts of Appeals have by scholarly analysis determined the metes and bounds of the principle in the much cited case of *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, and held valid patents far less impressive than those in the instant case. Yet this Court took no exception to such interpretations of the *Cuno Engineering* case; for it denied review of such decisions; *Brown & Sharpe Mfg. Co. et al. v. Kar Engineering Co., Inc.*, 154 F. (2d) 48 (C. A. 1) (certiorari denied, 328 U. S. 869, Petition for Rehearing denied, 329 U. S. 822); *Falkenberg v. Bernard Edward Co.*, 175 F. (2d) 427 (C. A. 7) (certiorari denied, 338 U. S. 870).

CONCLUSION.

We submit that respondent's brief has evaded all of the issues raised and has advanced no reason why this Court should not grant the Petition.

Respectfully submitted,

BLYTHE D. WATTS,
MORRIS HIRSCH,
Counsel for Petitioner.

GEORGE H. DESSION,
Of Counsel.

October 4, 1951.

26

NOV 23

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

PETITIONER'S REPLY
to
Respondent's Brief Opposing Petition for Rehearing of Order Denying Petition for Writ of Certiorari.

BLYTHE D. WATTS,
MORRIS HIRSCH,
Counsel for Petitioner.

GEORGE H. DESSION,
Of Counsel.

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 1-9847

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,

Petitioner,

vs.

ALLIED LATEX CORPORATION,

Respondent.

PETITIONER'S REPLY

to

Respondent's Brief Opposing Petition for Rehearing of Order Denying Petition for Writ of Certiorari.

Respondent's resort to sarcasm is evidently for lack of a better answer to the Petition for Rehearing.

Yes, the silly petitioner had heard of retroactive statutes, but wonders if the all-wise respondent knows that the Constitution forbids retroactive laws which impair the obligation of contract.

Petitioner also knew that this is a civil suit and not a criminal case. The term "ex post facto" was used in the Petition for Writ (p. 13) in its literal sense of "after the act" and was used in the Petition for Rehearing in that sense and also because retroactive and retrospective laws include ex post facto laws. *Calder v. Bell*, 3 Dall. 386, 388, 1 L. Ed. 648, 649.

Petitioner's position which respondent seems not to have understood may be simply restated as follows:

Congress has no power to impair the obligations of contract. *Calder v. Bell, supra; Continental Illinois N. B.*

& T. Co. v. Chicago Rock Island & Pacific Co., 294 U. S. 648, 680, 79 L. Ed. 1110, 1130.

The Courts may not impair contract obligations. *Muhlker v. N. Y. & Harlem R R*, 197 U. S. 544, 49 L. Ed. 872, 25 S. Ct. 522.

The laws in force at the time of execution of a contract are a part thereof. *Home Building & Loan Assn. v. Blaisdell*, 290 U. S. 398, 78 L. Ed. 413, 54 S. Ct. 231.

A patent is a contract. *Seymour v. Osborne*, 11 Wall. 516-533, 20 L. Ed. 33.

Under the foregoing principles of law a patent should be construed under the laws and the decisions of this Court prevailing when the patent issued and not under laws and decisions of a later date which changed the laws or decisions under which the patent issued and impaired the obligations of the patent contract.

No, petitioner had not overlooked either the fact that a patent must issue *before* it can be invalidated by the Courts; or this Court's decision in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84. That decision was cited and quoted from on page 4 of the Petition.

Apparently respondent overlooked the showing on pages 3 to 5 of the Petition that this Court has constantly adhered to the "constitutional standard" on the question of invention; and has never invalidated a patent on a law or rule forbidden by the Constitution, whether it be called retroactive, retrospective or ex post facto. None of the patent decisions handed down by this Court in the past ten years changed the previously existing law as to the standard of invention.

The same cannot be said for the Court below. That Court misconstrued this Court's decisions, identified on page 2 of the Petition for Rehearing, and, based on that misconstruction, and long after the fact of issuance of

the patents, evolved an unprecedented basis for invalidating the patents. Since that decision on that "after the act" rule seriously impairs the obligations of the patent contracts here involved, it is not permitted under the foregoing authority and should not be condoned.

The ground stated on page 1 of the Petition for Rehearing is new even though it is supported by facts previously cited in support of other grounds. Respondent evidently has ignored the distinction between grounds and facts since the same facts may support different grounds.

The Petition for Rehearing should be granted.

Respectfully submitted,

BLYTHE D. WATTS,
MORRIS HIRSCH,
Counsel for Petitioner.

GEORGE H. DESSION,
Of Counsel.

Dated: Cleveland, Ohio,
Nov. 21, 1951.

In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,

Petitioner,

vs.

ALLIED LATEX CORPORATION,

Respondent.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Petitioner prays that this Court grant rehearing on its Order of October 22d, 1951, denying Petition for Writ of Certiorari, and that a Writ issue to review the Judgment of the Court of Appeals for the Second Circuit in the above cause, as prayed for in the Petition filed August 20, 1951.

REASONS FOR GRANTING REHEARING.

1. A substantial ground available to Petitioner but not previously presented is that in invalidating the patents here involved the Court below acted beyond the powers granted by the Constitution of the United States.

Under Section IX of the Constitution of the United States, which prohibits the passing of *ex post facto* laws, Congress does not have the power to invalidate a patent by a law enacted after issuance of the patent. Likewise the Constitution did not give the Judiciary any power to create *ex post facto* rules and thereon to invalidate a previously granted patent. In other words, a patent is to be judged

according to the statutes and decisions of this Court in force at the time the patent issued and not in accordance with statutes enacted or decisions handed down long after the patents issued.

That the patents here involved are valid under the statutes and decisions of this Court prevailing at the time the patents issued is shown by admissions of the Court below.

The Court below held as to both patents:

> "It is perhaps interesting that an obvious need was not met sooner in this industry and *certainly in old days that would have told strongly in favor of the patent.*" (R 422.)*

and as to the Electrical Test patent held:

> "*Undoubtedly this would have been held invention in times past,* but now the climate of opinion has changed to require definite novelty in idea and not new adaptations of an old idea." (R. 421.)

The patents here involved were invalidated on decisions of this Court, handed down several years after August 27, 1940 and June 3, 1941 when the patents were issued. Those decisions are as follows:

Sinclair & Carroll Co. v. Interchemical Corp., 325 U. S. 327, decided May 21, 1945;

Jungerson v. Ostby & Barton Co., 335 U. S. 560, decided Jan. 3, 1949;

Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corp., 340 U. S. 147, decided Dec. 4, 1950.

In invalidating the patents on those decisions, the Court below misconstrued them so that it appears that it was this Court which had acted beyond the powers granted by the Constitution.

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* Emphasis is ours unless otherwise noted.

The Visual Test patent was held invalid because

> "overwhelming simplicity must always have its effect in contradicting novelty. Great Atlantic & Pacific Tea Company v. Supermarket Equipment Co., 340 U. S. 147." (R. 419.)

This Court has never held that simplicity, whether overwhelming or not, is a ground for holding a patent invalid. Indeed, "startling" simplicity was one of the grounds on which the patent was sustained in the case of *Minerals Separation et al. v. James Hyde*, 242 U. S. 261, where the Court said, on page 268,

> "The simplicity of the operation, as compared with the prior attempts is startling."

This Court did not hold in the foregoing *A. & P.* case that the patent was invalid because of simplicity. On the contrary, the Court held that the patent was invalid because it united

> "old elements with no change in their respective functions," (p. 152).

Moreover, in that case, Mr. Justice Douglas, with whom Mr. Justice Black agreed, said in a concurring opinion,

> "The standard of patentability is a constitutional standard; * * * The question of invention goes back to the constitutional standard in every case." (pp. 155, 6.)

In that case, this Court followed its previous decision in the case of *Williams Manufacturing Co. v. United States Machinery Co.*, 316 U. S. 364, which reiterated previously existing law in the following language:

> "These findings are to the effect that the new combinations, while they involve old mechanical construction, combine these in a new way so as to produce an improved result. * * * The claim that the combinations are merely of old elements, which perform no new

function and produce no new result, must be overruled." (p. 367.)

In holding that

> "the climate of opinion has changed to require definite novelty in idea, and not merely new adaptations of an old idea;"

and that

> "later decisions do not support the plaintiff's reading of directional signals." (R. 421.)

the Court below mistakenly relied on the foregoing *Sinclair & Carroll, Jungerson* and *A. & P.* decisions for they do not support the claim made for them by the Court below. Each decision is based on this Court's decision in *Cuno Engineering Corp. v. Automatic Devices Corporation*, 314 U. S. 84 which reaffirmed the rule as to invention which prevailed at the time the patents in suit were issued. In that case this Court said:

> "Under the statute (35 U. S. C. 31; RS 4886) the device must not only be 'new and useful', it must also be 'an invention' or 'discovery'. * * * if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art." (p. 90.)

The language of this *Cuno* decision was later expanded in the *Sinclair and Carroll* case as follows:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject matter display 'invention', 'more ingenuity * * * than the work of a mechanic skilled in the art'. (Citing many cases) * * * Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee." (p. 330.)

Thus, the very decisions on which the Court below invalidated the patents in suit established the fact that this Court has never resorted to *ex post facto* rules in invalidating patents but that, on the contrary, it has always been careful not to exceed the powers granted to it by the Constitution. The Court below has exceeded those powers and has ascribed, as authority, decisions of this Court which, as we have seen, are all in strict accord with constitutional provisions.

2. An intervening circumstance of substantial or controlling effect is that the decisions below in this case and in the companion case of *Frank B. Killian & Co. v. Allied Latex Corp.*, 188 F. (2d) 940 have already become established precedents in the Second Circuit.

In the few months since these decisions were handed down, the Courts in the Second Circuit have relied on one or both of them as authority for invalidating patents in at least three cases as follows:

Kleinman v. Betty Dain Creations, Inc., 189 F. (2d) 546;

Landis Machine Co. et al. v. Parker-Kalon Corp. et al., 190 F. (2d) 543;

Van der Horst Corp. of America v. Chromium Corp. of America, 98 F. Supp. 412.

Thus the present decisions have already attained the status of controlling precedents in the Second Circuit and will certainly continue to stand as such precedents unless corrected by this Court.

However, other Circuits have not followed, approved or even cited either of these decision.

Since the decisions in these cases were handed down by the Court of Appeals, the patent bar has become convinced that it has now become impossible to sustain a pat-

ent in the Second Circuit although patents may be sustained in other circuits as heretofore. Accordingly, on the slightest provocation, suit for Declaratory Judgment is brought in the Second Circuit to assure invalidation of the patent involved, but that Circuit is avoided like the plague when it comes to suit for patent infringement. Thus when one patent controversy arises, two nearly concurrent suits result, one for Declaratory Judgment in the Second Circuit, and one for infringement in some other Circuit with the ensuing inevitable interlocutory proceedings in both courts while the parties are jockeying for position.

This is exemplified by the recent decision of *Remington Products Corporation, et al. vs. American Aerovap, Inc.*, 97 Fed. Supp. 644, S. D. N. Y., now on appeal to the Court of Appeals.

This is an intolerable situation which could be corrected with resultant saving of the time and attention of the Federal Judiciary if this Court would bring the Second Circuit into line with this Court and with the other Circuit Courts.

CONCLUSION.

For the foregoing reasons, petitioner respectfully submits that the petition for rehearing should be granted.

BLYTHE D. WATTS,
MORRIS HIRSCH,
Attorneys for Petitioner.

GEORGE H. DESSION,
Of Counsel.

Certificate of Counsel.

I hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 33 of the Rules of this Court.

BLYTHE D. WATTS,
Counsel for Petitioner.

Dated: Cleveland, Ohio.
Nov. 5, 1951.

FILED
NOV 15 1951
CHARLES ELMORE CROPLEY

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 257

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

RESPONSE TO PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Charging that the Court of Appeals, in invalidating the patents in suit, "acted beyond the powers granted by the Constitution of the United States", petitioner invokes Article I, Section 9, of that charter which provides, in its third paragraph, that "No bill of attainder or *ex post facto* law shall be passed". Could it be that the Court of Appeals passed a bill of attainder or an *ex post facto* law? Well, not exactly; but it did "create" an *ex post facto* rule, "thereon to invalidate a previously granted patent"! The invocation of the Fifth and Fourteenth Amendments in the petition for rehearing in the companion *Killian* case was silly enough, but this is even worse—if possible. The *ex post facto* laws proscribed by Article I, Section 9 of the Constitution are criminal and penal laws. *Johannessen* v. *United States*, 225 U. S. 227. Apparently petitioner has never heard of retroactive statutes, which are a commonplace.

As a matter of fact, however, the Court of Appeals did *not* declare the patents in suit invalid on the basis of petitioner's so-called *ex post facto* rule respecting patentable invention. As pointed out at some length in our brief

in opposition to the petition for certiorari, the Court of Appeals held the first patent in suit invalid for lack of novelty, the second for anticipation, and neither for lack of invention, as to which the alleged *ex post facto* rule applies.

But even if the patents *had* been declared invalid for lack of invention, the Court of Appeals would not have been applying an *ex post facto* rule. Petitioner contends that the patents in suit "were invalidated on decisions of this Court, handed down several years after August 27, 1940, and June 3, 1941 when the patents were issued". The decisions referred to are *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U. S. 327, decided May 21, 1945; *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, decided Jan. 3, 1949; and *Great Atlantic and Pacific Tea Company* v. *Supermarket Equipment Corp.*, 340 U. S. 147, decided Dec. 4, 1950. It is interesting to note that if the Court of Appeals acted beyond its constitutional powers in invalidating the patents in suit on the basis of these three decisions because they were handed down "several years after" the invalidated patents had issued, this Court had been equally guilty. Gessler Patent No. 2,087,190 held invalid in the *Sinclair & Carroll* case, issued on July 13, 1937; Jungersen Patent No. 2,118,468, held invalid in the *Jungersen* case, issued on May 24, 1938; and Turnham Patent No. 2,242,408, held invalid in the *A & P* case, issued on May 20, 1941. In short, two of the patents invalidated by this Court in the cited cases were issued several years prior to the patents here in suit and one of them was issued at substantially the same time. And hasn't petitioner overlooked *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, itself decided in 1941 and invalidating a patent issued in 1929?

This whole *ex post facto* argument is absurd. The patent statutes have not been amended since the patents in suit were issued in 1940 and 1941. R. S. 4886 is the same today as it was then. This Court in the cases cited

was applying the statutes as they existed in 1940 and 1941 and earlier. There was nothing *ex post facto* about it. Besides, nobody has a vested right in a judicial decision or in the attitude of the courts. This Court has repeatedly overruled prior decisions. *Neirbo Co.* v. *Bethlehem Shipbuilding Corp.*, 308 U. S. 165. In *Erie R. Co.* v. *Tompkins*, 304 U. S. 64, this Court overruled decisions which began with *Swift* v. *Tyson*, 16 Pet. 1, 10 L. Ed. 865.

Rule 33, 2. of this Court confines the grounds on which a petition for rehearing may be filed "to intervening circumstances of substantial or controlling effect, or to other substantial grounds available to petitioner although not previously presented". Petitioner alleges both. The asserted substantial ground available but not previously presented, *was* previously presented on pages 6, 7, and 8 of the petition for certiorari. Petitioner is advancing the same old argument decked out in a new garb. The "intervening circumstance of substantial or controlling effect" is the citation of the Court of Appeals' decision, twice by itself, and once by the District Court for the Southern District of New York. Well, why not? Petitioner begs the question.

THE PETITION FOR REHEARING IS DEVOID OF MERIT AND SHOULD BE DENIED.

Respectfully,

ASHER BLUM,
10 East 40th Street,
New York 16, New York,

GEORGE E. MIDDLETON,
247 Park Avenue,
New York 17, New York,

Attorneys for Respondent.

November 12, 1951.

ACKERMAN PRESS, Phones BO 9-7107-8

MOTION FILED SEP 26 1951

IN THE

Supreme Court of the United States

October Term, 1951.
No. 257.

YOUNGS RUBBER CORPORATION,

Petitioner,

vs.

ALLIED LATEX CORPORATION,

Respondent.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari and Supporting Brief.

J. CALVIN BROWN,
Of the Bar of the United States Supreme Court.
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Los Angeles 14, California,
Petitioner, Amicus Curiae.

Parker & Company, Law Printers, Los Angeles

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,

Petitioner,

vs.

ALLIED LATEX CORPORATION,

Respondent.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Comes now J. Calvin Brown, of the Bar of the United States Supreme Court, and respectfully petitions for leave to file a brief *amicus curiae* on the grounds:

(1) That the decision of the United States Court of Appeals for the Second Circuit in the above entitled case formulates new rules for invalidating patents, which rules are contrary to those applied by this Court and by other Courts of Appeals and which vitally affect the patent system, and

(2) That these newly formulated rules are matters of great public interest and importance to inventors, patent

owners and all members of the publc who make, use or sell patented articles.

Petitioner, *amicus curiae,* is National President of The American Society of Mechanical Engineers, and feels that he would be remiss in his duty if he did not file this petition on behalf of the engineering profession generally and their clients.

The brief for which leave to file is hereby requested, accompanies this Petition.

This Petition is presented in good faith and is filed solely in what is believed to be the public interest. Petitioner does not represent any of the parties hereto nor has he any interest in the specific subject matter of the suit.

J. Calvin Brown,
Petitioner, Amicus Curiae.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,

Petitioner,

vs.

ALLIED LATEX CORPORATION,

Respondent.

Brief Amicus Curiae on Petition for Writ of Certiorari.

In its decision in the above entitled case (188 F. 2d 945), the Court of Appeals for the Second Circuit held at page 948:

> "It will thus be seen that the patentees took one of the oldest of electrical conceptions and adapted it rather ingeniously to a particular need of this business. Undoubtedly this would have been held invention in times past, *but now the climate of opinion has changed to require definite novelty in idea, and not merely new adaptations of an old idea."**

*Emphasis supplied.

This holding seems to be in direct derogation of the statute 35 U. S. C. 31; R. S. 4886, which provides in part:

> "Any person who has invented or discovered any new or useful art, machine, manufacture, or composition of matter, or *any new and useful improvements thereof,* * * * may * * * obtain a patent therefor."

If a patent to be valid must embody "definite novelty in idea," no improvements can be validly patented. Such a rule, if permitted to stand, would effectively nullify the portion of the statute dealing with improvement patents and would make it impossible for any improvement patents to be sustained hereafter in the Second Circuit.

It has never been the rule in this Court that a patent to be valid must embody "definite novelty in idea, and not merely new adaptations of an old idea." On the contrary, practically every patent sustained by the Supreme Court has belonged to the class of improvement patents wherein adaptations of old ideas alone are involved. Patents which comply with the requirements of the foregoing new rule can probably be counted on the fingers of one hand.

The question of law involved in the above stated new rule has never before been raised, is of vital importance to all persons and companies having to do with inventions and patents and is a direct challenge to the statutes. It should be decided by this Court.

For these reasons, it is urged that the Petition for Writ of Certiorari be granted.

J. Calvin Brown,

Petitioner, Amicus Curiae.

September 20, 1951.

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CHARLES ELMORE CROPLEY
CLERK

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 257

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

RESPONDENT'S OBJECTION TO THE FILING OF A BRIEF AS AMICUS CURIAE BY J. CALVIN BROWN.

Mr. J. Calvin Brown of Los Angeles, California, has filed a petition for leave to file a brief as *amicus curiae* in support of the petition for a writ of certiorari herein, and appends to his petition the brief he would like to file. Respondent's consent was not asked but would have been refused in any case for the following reasons:

As pointed out in our objection to the filing of an *amicus* brief in the companion *Killian* case, Mr. Brown, appearing as an individual, arrogates to himself the right to speak "on behalf of the engineering profession generally and their clients", but fails to present his credentials as the authorized spokesman for this large body of citizens. He also identifies himself as "National President of The American Society of Mechanical Engineers", and thereby seeks to give the impression that he is authorized to speak in its behalf. But here again no credentials are presented and Mr. Brown's views must, therefore, be considered as merely his own.

As in his petition in the companion *Killian* case, Mr. Brown makes no attempt to comply with the provision of this Court's Rule 27, 9 (c) requiring that one seeking to file an *amicus* brief when consent has been refused shall

> "set forth facts or questions of law that have not been, or reasons for believing that they will not adequately be, presented by the parties".

The only point made by Mr. Brown in his proposed brief is that the Court of Appeals erred in writing of the Electrical Test Patent:

> "Undoubtedly this would have been held invention in times past, *but now the climate of opinion has changed to require definite novelty in idea, and not merely new adaptations of an old idea.*"

This same sentence was quoted on page 6 of the petition for certiorari and criticized on pages 7 and 8. The burden of petitioner's argument was that the Court of Appeals had magnified and distorted recent decisions of this Court on invention. Mr. Brown now says that the quoted statement "seems to be in direct derogation of the statute, 35 U. S. C. 31; R. S. 4886", and "a direct challenge" to it, which is very much the same argument.

The answer to both petitioner and Mr. Brown is found on pages 9 and 10 of respondent's brief in opposition: that the claims in suit of the Electrical Test Patent were *not* held invalid for lack of invention, but for "anticipation", which is not the same thing, so that "the climate of opinion" with respect to invention, whether changing or not, had nothing to do with the ultimate decision. Moreover, it is clear that the Court of Appeals, in the quoted passage, was doing no more than restating the law as defined by this Court in numerous decisions.

THE PETITION FOR LEAVE TO FILE A BRIEF AS AMICUS CURIAE SHOULD BE DENIED.

Respectfully,

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September 28, 1951.